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Supreme Court of the United States

October Term, 1947

No. 652

HAROLD E. EDGERTON,

*Petitioner,*

*vs.*

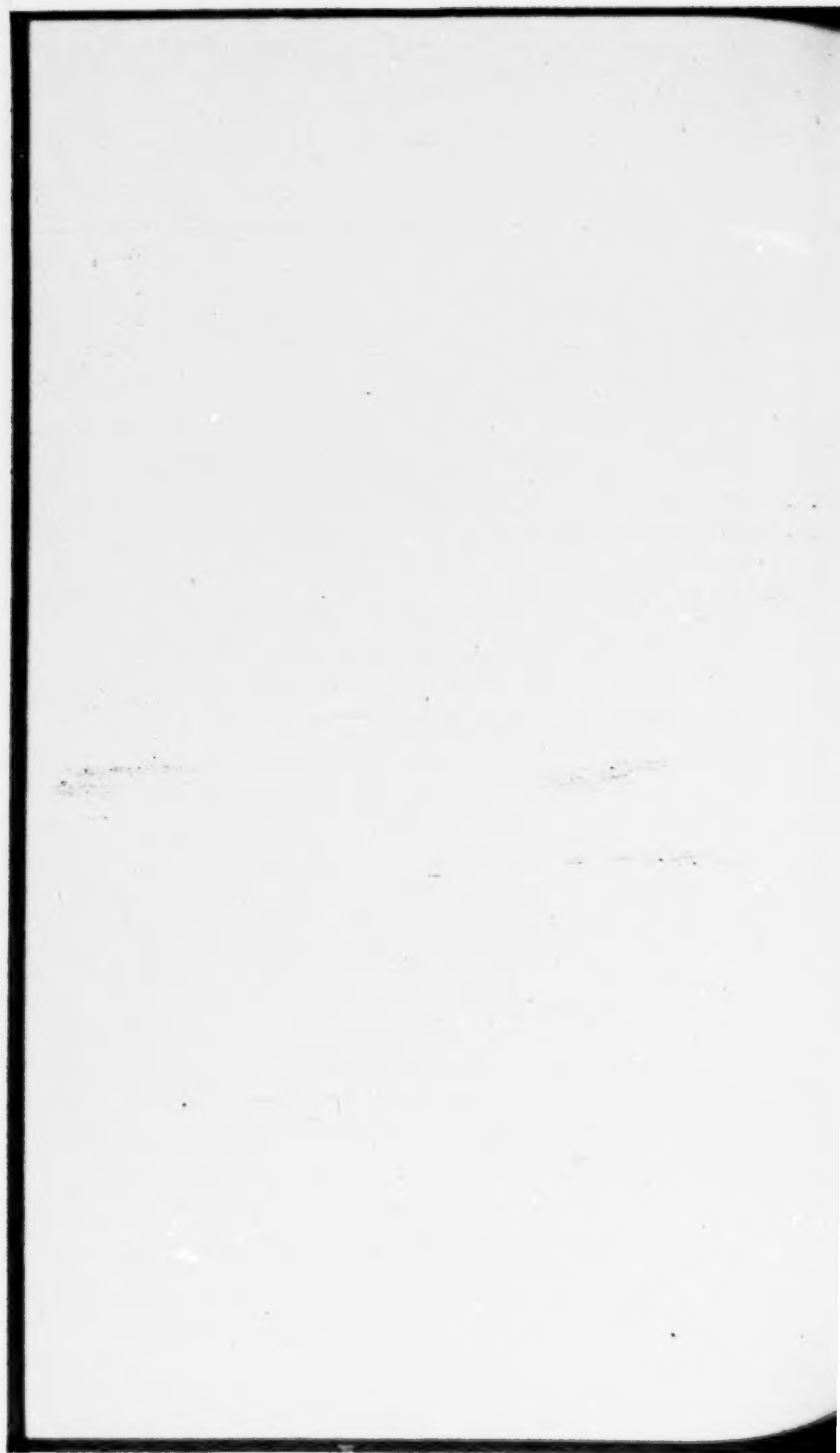
LAWRENCE C. KINGSLAND, Commissioner  
of Patents,

*Respondent.*

PETITION FOR A WRIT OF CERTIORARI TO THE  
UNITED STATES COURT OF APPEALS FOR  
THE DISTRICT OF COLUMBIA AND BRIEF IN  
SUPPORT THEREOF.

✓  
DAVID RINES,  
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✓  
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*Of Counsel.*



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# Supreme Court of the United States

October Term, 1947

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No. ....

HAROLD E. EDGERTON,

*Petitioner,*

*vs.*

LAWRENCE C. KINGSLAND, Commissioner  
of Patents,

*Respondent.*

## PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA

*To the Honorable the Chief Justice and the Associate  
Justices of the Supreme Court of the United States:*

Your petitioner, Harold E. Edgerton, by his attorneys, respectfully prays that a writ of certiorari be issued to the United States Court of Appeals for the District of Columbia to review a judgment of that Court entered in the above cause December 4, 1947 (R. p. 579), affirming the dismissal of your petitioner's complaint by the District Court, request for rehearing having been denied January 6, 1948 (R. p. 588).

On the said December 4, 1947, the said Court of Appeals rendered three separate judgments, one in each of three

consolidated suits between the same parties. The judgment in No. 9361 only is involved on this petition. Not all the issues involved in that suit, No. 9361, moreover, are pertinent on this proceeding. On the contrary, this petition deals with the one issue only as to the proper construction to be placed upon the recent holdings of this Honorable Court in *Hoover Company v. Coe*, 325 U. S. 79.

### **The Question Presented**

The question presented by this petition involves the construction of a United States statute, Section 4915, R.S. (U.S.C. Title 35, Sec. 63), and it is of great public importance. This statute and also another statute, Section 4911, R.S. (U.S.C. Title 35, Sec. 59a), are quoted on pp. 13 to 15, *infra*. Section 4915 provides for the filing of a complaint in the District Court whenever a patent is refused by the Board of Appeals of the Patent Office.

Prior to the decision of this Court in the Hoover case, Section 4915 was uniformly construed to mean that such complaint could not be filed in the District Court until after a final decision by the Patent Office upon the whole merits of the patent application.

The question presented, therefore, is whether, from now on, contrary to the practice heretofore prevailing, it will be necessary for a patent applicant to resort to the District Court piecemeal upon each and every separate occasion that the Patent Office may render a separate decision involving one or more separate claims of the patent application.

## **The Reasons Relied Upon for the Allowance of the Writ of Certiorari**

The answer to this question will affect the rights of every applicant for patent whose application has been unjustly refused by the Patent Office piecemeal.

In the present instance, the Patent Office, as will be stated more fully in detail hereinafter, had in 1941 rendered a piecemeal decision adjudicating some only of the claims involved in your petitioner's patent application, Serial No. 685,501, filed August 16, 1933 (R. p. 207), but it had not at that time passed upon any of the remaining claims of the application. In the words of the Court of Appeals for the District of Columbia (R. p. 581),

“At the time of the rejection of the static inverter claims other claims in the appellant's application had not yet been disposed of.”

The Patent Office did ultimately render a complete decision upon the whole merits of your petitioner's application, but not until several years later, in 1945.

Under the practice in force prior to the Hoover decision, your petitioner was unable to avail himself of the provisions of the said Section 4915 of the Revised Statutes until after the complete decision upon the whole merits, in 1945. He did not, therefore, file any complaint in the District Court following upon the Patent Office piecemeal decision of 1941.

The Court of Appeals for the District of Columbia holds, however, that this Court's decision in the Hoover case has now changed the law (R. p. 582):

“The appellant contends that if recourse to the courts had been taken within six months after the decision of the Board of Appeals in 1941 it would have

been premature since the Board's rejection of claims 74 and 76 to 81 inclusive at that time did not then dispose of the entire application. But this contention is answered adversely to the appellant by *Hoover Company v. Coe*, 325 U. S. 79 (1945)."

If the understanding of the Court of Appeals as to the holdings of this Honorable Court in the Hoover case is correct, then those holdings have, indeed, been revolutionary, for they have overturned a practice that has been in force since at least the time of King James, according to which a party may not appeal piecemeal.

It is accordingly very important to obtain promptly a ruling as to whether the Court of Appeals correctly understands the holdings of this Honorable Court in the Hoover case.

As the Commissioner of Patents has his official residence in the District of Columbia, and as all *ex parte* complaints under Section 4915 are necessarily, therefore, filed in the District Court for the District of Columbia, there appears to be no possibility of obtaining a different ruling from any other Court of Appeals as to the construction to be placed upon this Court's holdings in the Hoover case.

If the decision of the Court of Appeals should be allowed to stand, it will be productive of much mischief. It will add greatly to the already heavy burdens carried by those who, relying upon Article 1, Section 8, of the United States Constitution, relating to the promotion of the progress of science and useful arts, apply to the Patent Office, in good faith, for patents to cover inventions that they have made, at great expense and after considerable effort, in order to benefit the public. The record shows that your petitioner's invention is among those that have greatly benefited the public.

It has heretofore been the policy of the law to encourage, not to hinder, such benefactors. It will not, however, encourage an applicant for patent to know that, before he can obtain his patent, he will be compelled to file as many separate complaints in the District Court as there may be separate piecemeal decisions by the Patent Office relating to separate claims of his application, each complaint involving a separate trial in the District Court on substantially the same identical record, together with many repetitions of the presentation of that identical record in the Court of Appeals.

If the decision of the Court of Appeals should be allowed to stand, the prosecution of an application in the Patent Office will revert to the condition described as far back as 1905 in connection with a related matter by the Court of Appeals itself, *Allen v. U. S. ex rel. Lowry*, 26 App. D. C. 8, 18:

"if successive appeals be permitted, the result would be only to add another terror to the many surrounding an interference proceeding in the Patent Office. From the simple and summary mode first adopted for determining the question of priority of invention, that proceeding, by system of Patent Office rules, has grown to be a veritable old man of the sea, and the unfortunate inventor who becomes involved therein is a second Sinbad the Sailor \* \* \*. Should we affirm the decision of the court below, \* \* \* we should be placing still another burden of successive piece-meal appeals upon the unfortunate interferant in a proceeding which, when decided, is not final. \* \* \*"

### Summary of the Matter Involved

Your petitioner is associate professor of electrical engineering at the Massachusetts Institute of Technology, Cambridge, Massachusetts. He is a pioneer in the art of speed photography.



On August 16, 1933, he filed in the United States Patent Office his before-mentioned application, Serial No. 685,501.

His invention, however, was made as far back as 1928 or 1929 and it aroused great interest from the very first. To satisfy this interest, your petitioner demonstrated his invention very widely, and he published numerous papers in the technical periodicals (R. pp. 123, 124).

This stimulated the filing by others of applications covering his invention, with the result that your petitioner became involved in numerous interferences, which have held up the issue of his patent, even up to the present day.

As a result of these numerous interferences, your petitioner's application contains a very large number of claims.

Among these are claims 74 and 76 to 81 (R. pp. 3 to 5) referred to in the above quotations from the decision of the Court of Appeals. These claims 74 and 76 to 81 each specifies a flash-producing system comprising a new combination of old elements, one of which is a "static inverter". It will not be necessary, for present purposes, to explain the meaning of the term "static inverter". The term is introduced here merely because the Court of Appeals finds it convenient to refer to these claims 74 and 76 to 81 as static-inverter claims (R. p. 580).

These static inverter claims 74 and 76 to 81 originated in patent 2,043,484 (R. p. 367), issued June 9, 1936, on application filed June 15, 1934, to a predecessor of Cities Service Oil Co., as assignee of one Benjamin Miller. Though these static-inverter claims 74 and 76 to 81 cover your petitioner's invention, though your petitioner had disclosed this invention to the Patent Office, in his said application, Serial No. 685,501, as far back as August 16, 1933, long prior to Miller's filing date, June 15, 1934, the



Patent Office had inadvertently permitted the Miller patent 2,043,484 to issue without first declaring an interference to determine who was the first inventor.

Your petitioner, therefore, promptly copied these static-inverter claims 74 and 76 to 81 from the Miller patent 2,043,484, and requested that his application be put into interference with this patent, for the purpose of determining priority of invention. Pursuant to this request, Interference 74,402 was declared on June 11, 1937 (R. p. 581).

After the declaration of the interference, the interfering parties filed sealed preliminary statements alleging their respective dates of invention. When these preliminary statements were opened by the Patent Office, it was found that the dates of invention alleged by Miller as to these static-inverter claims 74 and 76 to 81 were subsequent even to your petitioner's filing date, August 16, 1933 (R. pp. 12, 23). There appeared to be no reason, therefore, insofar as these static-inverter claims 74 and 76 to 81 were concerned, for continuing the interference controversy further to the stage of taking testimony to prove who was the prior inventor.

The Patent Office, therefore, issued an order requiring Miller to show cause why judgment should not be summarily rendered against him as to these static-inverter claims 74 and 76 to 81 (R. pp. 12, 23). This was the same procedure that is described in *News Projection Corporation v. Western Union Tel. Co.*, 38 F. Supp. 854, 855.

To avoid such judgment, Miller, under the provisions of Rule 122 of the Rules of Practice of the Patent Office, filed a motion to dissolve the interference (R. p. 23).

The grounds alleged in the motion to dissolve were so entirely unfounded (as was demonstrated later by testi-

mony in the District Court, R. pp. 182 to 201) that no one abreast of the art could possibly have been misled thereby. But the Patent Office is by no means abreast of the art. In *Westinghouse Electric & Manufacturing Co. v. Radio Corporation*, 24 F. Supp. 933, 939, 943, for example, the Patent Office was severely criticized for misinterpretations and misunderstandings arising out of its lack of familiarity with the art.

Owing to similar misinterpretations and misunderstandings in the said Interference 74,402, the Primary Examiner of the Patent Office, on November 23, 1938 (R. p. 525), granted Miller's motion to dissolve as to the static-inverter claims 74 and 76 to 81, erroneously holding that your petitioner's application, Serial No. 685,501, does not disclose a static inverter.

Your petitioner appealed to the Board of Appeals, but that tribunal, on July 18 and April 4, 1939, affirmed the Primary Examiner's decision dissolving the interference (R. p. 23).

Interference 74,402 was thereupon summarily dissolved without affording your petitioner an opportunity to take *inter-partes* testimony to demonstrate that his application does actually disclose a static inverter. He was not permitted to present any testimony until he appeared in the District Court.

From the Patent Office decision dissolving the interference, your petitioner was without remedy to seek a review in the courts, since it was not a final decision upon the whole merits, *Allen v. U. S. ex rel. Lowry, supra*, *American Cable Co. v. John A. Roebling's Sons Co.*, 62 App. D. C. 103, 65 F. 2d 801, 802, *Synthetic Plastics Co. v. Ellis-Foster Co.*, 78 F. 2d 847, 848, *Gyro Process Co. v. Coe*,

70 App. D. C. 390, 107 F. 2d 195, 199.. The only course open to your petitioner, therefore, was to resume the *ex parte* prosecution of the application, in order to obtain an adjudication of the remaining claims of his application. The further *ex parte* proceedings are described in the decision of the Court of Appeals, as follows (R. p. 581):

"On March 26, 1940, the Primary Examiner rejected the claims upon the same grounds as those upon which he had dissolved the interference. On December 23, 1940, he repeated this ruling and made it final. On August 1, 1941, the Board of Appeals affirmed this rejection. Thereafter within the time allowed by the rules of the Patent Office, the appellant filed a petition for rehearing. On September 16, 1941, this was denied by the Board of Appeals. No appeal under Rev. Stat. § 4911 (1875), 35 U. S. C. § 59a (1940), was taken to the Court of Customs and Patent Appeals. The complaint under Rev. Stat. § 4915 was not filed in the District Court within six months after September 16, 1941."

The complaint was not filed until June 1, 1945. This was within six months of the 1945 Patent Office decision, upon the whole merits.

The Patent Office, the District Court and the Court of Appeals have ruled that, because your petitioner did not avail himself of the provisions of either Section 4911 or Section 4915 of the Revised Statutes at the time of the Patent Office piecemeal decision of 1941, your petitioner's right to the static-inverter claims 74 and 76 to 81 has become final and *res judicata*, irrespective of your petitioner's incontrovertible showing, by evidence, in the District Court, that his original application did, in fact, disclose a static inverter, and that the Patent Office holding to the contrary, upon the basis of which Interference 74,402 was dissolved, had been erroneous.

The complaint (R. p. 1) in the District Court involved not only the static-inverter claims 74 and 76 to 81, but also a further claim 222 (R. pp. 583 to 585) which had not yet been adjudicated by the Patent Office at the time of the piecemeal decision of 1941.

### Jurisdiction

The jurisdiction of this Court is invoked under Section 240(a) of the Judicial Code, 28 U. S. C. 347, as amended by the Act of February 1, 1925. The judgment of the Court of Appeals, as already stated, was entered on December 4, 1947, and the petition for rehearing was denied on January 6, 1948. This judgment was entered on appeal from a judgment by the District Court for the District of Columbia dismissing a complaint brought under the provisions of Section 4915 U. S., to have remedy from the refusal of the Board of Appeals of the Patent Office to grant a patent to your petitioner (R. p. 30). Some of the previous decisions of this Court bearing on jurisdiction are:

Butterworth v. Hill, 114 U. S. 128.

Gandy v. Marble, 22 U. S. 432.

Morgan v. Daniels 153 U. S. 120.

Steinmetz v. Allen 192 U. S. 543.

American Steel Foundries v. Robertson, 262 U. S. 209.

Hoover Company v. Coe, *supra*.

WHEREFORE, your petitioner, feeling himself aggrieved by the judgment of the Court of Appeals for the District of Columbia, respectfully prays that a writ of certiorari be issued out of and under the seal of this Honorable Court, directed to the said United States Court

of Appeals for the District of Columbia, commanding that Court to certify and send to this Court for its review and determination, on a day certain to be herein named, a full and complete transcript of the record and all the proceedings in the case numbered and entitled on its docket No. 9361, Harold E. Edgerton, Appellant, v. Lawrence C. Kingsland, Commissioner of Patents, Appellee, and that said judgment of the said Court of Appeals for the District of Columbia may be reversed by this Honorable Court, and that your petitioner may have such other and further relief in the premises as to this Honorable Court may seem meet and just.

DAVID RINES,  
*Attorney for Petitioner.*

FRANK W. DAHN,  
*Of Counsel.*

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We hereby certify that we have read the foregoing petition for a Writ of Certiorari, and that in our opinion it is well founded and presents grounds whereon the prayer ought to be granted, and we further certify that it is not intended for purposes of delay.

DAVID RINES,  
*Attorney for Petitioner.*

FRANK W. DAHN,  
*Of Counsel.*

# Supreme Court of the United States

October Term, 1947

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No. \_\_\_\_\_

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HAROLD E. EDGERTON,

*Petitioner,*

*vs.*

LAWRENCE C. KINGSLAND, Commissioner  
of Patents,

*Respondent.*

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## BRIEF IN SUPPORT OF THE PETITION FOR A WRIT OF CERTIORARI

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### I. The Opinion of the Court below

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The opinion of the Court of Appeals for the District of Columbia was rendered December 4, 1947 (R. p. 579). A petition for rehearing was denied January 6, 1948 (R. p. 588).

The District Court's Informal Memorandum and its Findings of Fact and Conclusions of Law appear on pages 27 to 29 of the record.

### II. Statement of the Case

The facts are set forth in the "Summary of the Matter Involved" in the petition for the writ of certiorari.

### III. Specification of Errors

The Court of Appeals for the District of Columbia erred:

1. In affirming the dismissal of your petitioner's complaint in the District Court, and upon a misconstruction of this Honorable Court's holdings in *Hoover Company v. Coe*, 325 U. S. 79.

2. In affirming the dismissal of your petitioner's complaint in the District Court upon the ground that your petitioner's right to the static-inverter claims 74 and 76 to 81 had become *res judicata*.

3. In holding, contrary to the practice uniformly in force prior to the decision in the *Hoover* case, that the proper time for your petitioner to have invoked Section 4911 or 4915 of the Revised Statutes was within six months of the Patent Office piecemeal decision of 1941, prior to any adjudication of your petitioner's application by the Patent Office upon the whole merits.

4. In refusing to decide the case upon its merits, and deciding it instead upon the ground of *res judicata*.

### IV. Statutes Involved

Sec. 4911, R. S. (U. S. C., title 35, sec. 59a). If any applicant is dissatisfied with the decision of the Board of Appeals, he may appeal to the United States Court of Customs and Patent Appeals, in which case he waives his right to proceed under Section 4915 of the Revised Statutes (U. S. C., title 35, sec. 63). If any party to an interference is dissatisfied with the decision of the board of interference examiners he may appeal to the United States Court of Customs and Patent Appeals, provided that such appeal shall be dismissed if any adverse party to such interference

shall within twenty days after the appellant shall have filed notice of appeal according to section 4912 of the Revised Statutes (U. S. C., title 35, sec. 60), file notice with the Commissioner of Patents that he elects to have all further proceedings conducted as provided in section 4915 of the Revised Statutes. Thereupon the appellant shall have thirty days thereafter within which to file a bill in equity under said section 4915, in default of which the decisions appealed from shall govern the further proceedings in the case.

Sec. 4915, R. S. (U. S. C. Title 35, sec. 63). Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal or decision; and the Court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there



are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross examination of the witnesses as the Court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit.

NOTE: The above statutes are quoted as amended by Act of August 5, 1939, after the declaration of Interference 74,402, Edgerton v. Miller.

## V. Summary of Argument

- A. The Courts will not entertain piecemeal appeals.
- B. The rule that piecemeal appeals will not be entertained has been enforced from the earliest times up to the present day.
- C. What is a final judgment?
- D. Examples of final judgments.
- E. It is no more permissible to appeal piecemeal from an administrative body than from a District Court.
- F. The same principle as to piecemeal appeals applies to the Patent Office.
- G. Hoover Company v. Coe, 325 U. S. 79, has not changed the law that an applicant for patent may not appeal piecemeal.

## VI. Argument

### A. The Courts Will Not Entertain Piecemeal Appeals.

The general rule was stated by Mr. Justice Brandeis in Collins v. Miller, 252 U. S. 364, 370:

"A case may not be brought here by appeal or writ of error in fragments. To be appealable, the judgment must be not only final, but complete [citing cases]. And the rule requires that the judgment to be appealable should be final not only as to all the parties, but as to the whole subject-matter and as to all the causes of action involved . . . Here a single judgment deals with the detention on three affidavits. Only one branch of the case has been finally disposed of below, therefore none of it is ripe for review by this court."

The same Justice held later, in *Nyanza Steamship Company v. Jahneke Drydock*, 264 U. S. 439:

"The decree leaves the cause of action *in personam* for damage undisposed of . . . the judgment must be not only in its nature final, but a complete disposition of the cause."

See also *Catlin v. United States*, 324 U. S. 229, 233, 234, and *Gospel Army v. City of Los Angeles*, 331 U. S. 543.

An appellate court may not waive this requirement of finality, even where both parties to the suit consent that it do so. In *Florian v. United States*, 114 F. 2d 990, 993, for example, where the Circuit Court of Appeals for the Seventh Circuit assumed jurisdiction to decide an appeal under "unusual" circumstances, because

"we are not disposed, in view of the stipulation and attitude of the parties, to invoke any technical reasoning against it",

the Supreme Court, *United States v. Florian*, 312 U. S. 656,

"reversed for want of jurisdiction in the Circuit Court of Appeals because of the absence of a final judgment in the District Court."

The Appellate Court will even go back of the pleadings to find out whether there has, in fact, been a final decision upon the whole merits, as in *Synthetic Plastics Co. v. Ellis-Foster Co.*, 78 F. 2d 847, 848, where the bill was so framed that it

"contains on its face sufficient allegations to confer jurisdiction upon the District Court. The exhibits, however, disclose that the Examiner of Interferences and the Board of Appeals did not decide the issue as to priority of invention in the interference proceedings and did not refuse a patent."

The Court, therefore, declined to take jurisdiction, looking behind the allegations of the bill to the true facts, to determine whether there had, in actual truth, been a final decision upon the whole merits of the controversy.

**B. The Rule That Piecemeal Appeals Will Not Be Entertained Has Been Enforced From the Earliest Times up to the Present Day.**

**a. The Practice Prior to the Enactment of the Federal Rules of Civil Procedure.**

In *Cobbledick v. United States*, 309 U. S. 323, 325, this Court explained that

"Congress from the very beginning has, by forbidding piecemeal disposition on appeal of what for practical purposes is a single controversy, set itself against enfeebling judicial administration."

This rule has been consistently adhered to from the earliest times, *Beebe v. Russell*, 19 How. 283, 284:

"It has been the object of this court at all times . . . to restrict the cases which have been brought to this court . . . to those in which the rights of the parties have been fully and finally determined by judgments or decrees in the court below."

Though the appellate jurisdiction in the federal-system procedure is purely statutory, nevertheless, as stated in *McLish v. Roff*, 141 U. S. 661, 665, this

"was only declaratory of a well settled and ancient rule of English practice. At common law no writ of error could be brought except on a final judgment."

As stated in *Libbey-Owens-Ford Glass Co. v. Sylvania Industrial Corporation*, 154 F. 2d 814, 815,

"This carries out a federal policy going back to the early days of the Republic . . . . It is reiterated as a policy of desirable and affirmative substance 'against piecemeal litigation' in *Catlin v. United States*, 324 U. S. 229, 233, 234."

b. The Original Federal Rules of Civil Procedure Have Not Changed this Practice.

The Federal Rules of Civil Procedure were construed in *Reeves v. Beardall*, 316 U. S. 283, 286. There, a disposal of part of a case, relating to a promissory note, was held to be final, under the provisions of Rule 54 (b), because the remaining part of the case arose out of an entirely different matter, a contract not to change a will.

In the present case, however, the claims of your petitioner's application all relate to the same single invention. The same invention is covered by the static-inverter claims 74 and 76 to 81, and also by claim 222, which was likewise discussed in the decision of the Court of Appeals. Attention is invited to the decision of the Court of Appeals in the *Hoover* case, 79 App. D. C. 172, 175, 144 F. 2d 514, 517:

"Theoretically each patent claim is a distinct invention. Therefore, the refusal of any single claim appears in the pleadings under Section 4915, R. S. as the refusal of a patent on a distinct invention. Actually, however, in applications containing multiple claims the claims often do not represent distinct inventions but only different ways of describing a single invention."

As recently stated by the Court of Customs and Patent Appeals, in application of *Wood*, 155 F. 2d 547, 551,

"an applicant for a patent has the right to express in a single application and in more than one claim *the*

*same invention*, although worded in different language or including elements omitted in other claims" (italics supplied).

The Court went on to say that an applicant, "in a single application", may have

"article and method claims, Markush claims, species claims and broad and narrow claims",

all expressing "the same invention". Indeed,

"patent lawyers usually present and are by the Patent Office permitted to present several claims covering *the same invention*, though worded in different language" (italics supplied).

In *Libbey-Owens-Ford Glass Co. v. Sylvania Industrial Corporation*, *supra*, the Court held that the Rules of Federal Procedure, as construed in *Reeves v. Beardall*, *supra*, lend

"no countenance to the idea that different defenses to the *same* claim may be reviewed in piecemeal fashion" (italics the court's),

and concluded, page 817, that, in view of these Federal Rules,

"The law now carries out the historic federal policy . . . the policy is the fruit of experience."

There was a dissenting opinion that went off on another angle, but even the dissenting opinion agreed with the principle that prohibits (p. 824)

"the piecemeal disposition of what for practical purposes is a single controversy."

In *Leonard v. Socony-Vacuum Oil Co.*, 130 F. 2d 535, 536, the court explained that it was not the intent of the Rules of Federal Procedure

"to make such partial summary judgment final and appealable. In fact, had such been the intent, it would have brought about the very end desired to be avoided,—delay and waste of time in appealing piecemeal, even though the party still has a cause of action pending, where he may have a final judgment disposing of all controversies between the parties."

c. The Amended Federal Rules of Civil Procedure Have Likewise Not Changed This Practice.

As stated in *Western Contracting Corporation v. National Surety Corporation*, 163 F. 2d 456, 459, indeed, the practice even of *Reeves v. Beardall*, *supra*, is no longer in force, since

“the Amended Rules recently adopted by the Supreme Court \* \* \* reestablish the old practice even as to claims which are separate and distinct, except \* \* \*”

See also *Petrol Corporation v. Petroleum Heat and Power Co.*, 162 F. 2d 327, 329 and *Cannister Co. v. National Can Corporation*, 163 F. 2d 683, 685.

C. What is a Final Judgment?

It is therefore in order to determine what is a “final judgment”.

The term “final judgment” is defined in *Beebe v. Russell*, *supra*, at p. 285:

“When a decree finally decides and disposes of the *whole merits* of the cause, and reserves no further questions or direction for the future judgment of the court, so that it will not be necessary to bring the cause again before the court for its final decision, it is a final decree” (*italics supplied*).

See also *St. Louis, Iron Mountain & Southern Railroad Co. v. Southern Express Co.*, 108 U. S. 24, 28:

“a decree is final, for the purposes of an appeal to this court, when it terminates the litigation between the parties on the merits of the case, and leaves nothing to be done but to enforce by execution what has been determined.”

Nothing less is final, as explained in *Heike v. United States*, 217 U. S. 423, 430:

"Many interlocutory rulings and orders effectually dispose of some matters in controversy, but that is not the test of finality for purposes of appeal or writ of error. The purpose of the statute is to give a review in one proceeding after final judgment of matters in controversy in any given case. Any contrary construction of the Court of Appeals Act may involve the necessity of examining successive appeals or writs of error in the same case, instead of awaiting, as has been the practice since the beginning of the Government, for one review after final judgment, disposing of all controversies in that case between the parties."

#### D. Examples of Final Judgments.

##### a. Examples Prior to the Federal Rules of Civil Procedure.

An example of what is a final judgment is accorded by *Globe-Wernicke Co. v. Fred Macey Co.*, 119 F. 696, 703. In a suit for patent infringement and unfair competition, a demurrer as to the unfair competition was sustained, and the case proceeded to a trial of the infringement. It was held that the plaintiff could not appeal from the dismissal of the suit as to the unfair competition until after a decision as to the infringement:

"The bill was not founded upon two separate matters or transactions. The conduct of the appellee complained of consisted of the same acts. . . . the case proceeds until all the matters are decided, whereupon a final decree is entered."

The decision would have been different, of course, if the acts giving rise to the suit for patent infringement had not been the same as those giving rise to the suit for unfair competition, because two entirely different causes of action would then have been involved, *Zalkind v. Scheinman*, 139 F. 2d 895, 900, cert. denied, 322 U. S. 738.



Where two patents are in suit upon allied causes of action, and the bill is dismissed as to one, similarly, there can be no appeal until the final decree as to both, *Kelsey Wheel Co. v. Universal Rim Co.*, 296 F. 616, 623.

A similar question arose in *ex parte* National Enameling and Stamping Co., Petitioner, 201 U. S. 156, 160, and it was similarly held that a suit upon twelve claims of a single patent did not break up the one suit into twelve suits.

b. Examples Subsequent to the Federal Rules of Civil Procedure.

In *Leonard v. Socony-Vacuum Oil Co.*, *supra*, it appeared that suit had been brought under the Sherman Anti-Trust Act, alleging five items of damage. As to two of those five items, the defendants obtained summary judgment, and the plaintiff appealed. The appeal was dismissed, p. 536:

"It is obvious that plaintiffs here relied upon only one cause of action—damage to his business resulting from defendants' alleged violation of the Anti-Trust Act. The different elements of damage were not claimed to have resulted from different transactions but to have arisen from the one alleged cause of action based upon one conspiracy."

*Biggins v. Oltmer Iron Works*, 154 F. 2d 214, similarly, involved a suit to recover \$13,308.80 for five items of services rendered by the plaintiff as a sales representative for the period commencing in November, 1942, and extending to March 1, 1944. A summary judgment was entered as to two items only, totalling \$8,874.05. Before the trial upon the remaining three items amounting to \$4,434.75, the defendant appealed from the summary judgment as to the said two items. The Court of Appeals for the Seventh Circuit held that the summary judgment as to the two items was not appealable, because not final. The cause of action,



though based upon five items, constituted only a single claim for services rendered over a period of more than a year. The case was entirely unlike *Reeves v. Beardall*, *supra*, where the matters in controversy had been "entirely distinct."

It is not necessary, for present purposes, to explain why the appeal was actually permitted.

In *Libbey-Owens-Ford Glass Co. v. Sylvania Industrial Corporation*, *supra*, the Court of Appeals for the Second Circuit remarked, p. 814:

"An order merely striking one of several defenses and allowing the action to continue for adjudication of the rest would seem as nearly interlocutory as any pleading ruling can ever be."

The same would appear to apply to a piecemeal decision disposing of some claims only of a patent application, but permitting the prosecution of the remaining claims to continue.

While riding in a truck owned by a gas company, the plaintiff was injured through collision with a railroad train. Suit having been entered against the railroad alone, the defendant filed a third-party complaint, seeking to implead the gas-company owner and the driver of the truck. The lower Court sustained a motion to dismiss the railroad's third-party complaint for lack of jurisdiction. The Court of Appeals for the Fourth Circuit, *Baltimore and Ohio Railroad Co. v. United Fuel Gas Co.*, 154 F. 2d 545, dismissed an appeal from this ruling upon the ground that the District Court's ruling was not a final judgment.

**E. It is no More Permissible to Appeal Piecemeal From an Administrative Body Than From a District Court.**

The principle that a case is not appealable piecemeal is not confined to appeals from District Courts. It has been

uniformly held that preliminary and interlocutory orders of an administrative body, the same as those of the District Court, are not appealable. The administrative remedies must be exhausted before there may be any review of the administrative action, *United States v. Los Angeles & Salt Lake Railroad Company*, 173 U. S. 299, *Myers v. Bethlehem Shipbuilding Corp.*, 133 U. S. 41, 51, *Federal Power Commission v. Metropolitan Edison Co.*, 304 U. S. 375, 385, *Macauley v. Waterman Steamship Corp.*, 327 U. S. 540, 545, *Federal Power Commission v. Arkansas Power & Light Co.*, 330 U. S. 802. As stated in *Rochester Telephone Corp. v. United States*, 307 U. S. 125, 131, this is

"Partly . . . an aspect of the procedural philosophy pertaining to the federal courts whereby, ever since the Judiciary Act, Congress has been loath to authorize review of interim steps in a proceeding."

**F. The Same Principle as to Piecemeal Appeals Applies to the Patent Office.**

The same principle naturally applies to the Patent Office, since the Patent Office is an administrative body. It is the administrative body designated by Congress to issue patents, Section 481, R.S. (U.S.C. Title 35, Section 6).

It is now in order, therefore, to show that the same rule that has been applied in connection with other administrative bodies has been applied also in connection with the jurisdiction of the District Court, under Section 4915 of the Revised Statutes, and of the Court of Customs and Patent Appeals, under Section 4911 of the Revised Statutes.

Sections 4911 and 4915 of the Revised Statutes have been construed by the Court of Appeals of the District of Colum-

bia upon a number of occasions. In *Carlin v. Goldberg*, 45 App. D. C. 540, 544, for example, that Court remarked:

"The right of appeal from the decisions of the Commissioner of Patents to this court and the procedure by which such appeals may be perfected are purely statutory, and must be strictly followed. Short-cut methods in the Patent Office for the purpose of avoiding prolonged litigation and facilitating a final appeal contrary to express statutory procedure are not within the discretionary power of the Commissioner, and, if indulged, would lead to injustice and endless confusion."

Earlier still, more than a third of a century ago, in *Cosper v. Gold*, 34 App. D. C. 194, 197, the same Court held:

"We have had occasion heretofore to call attention to the fact that the jurisdiction of this court to entertain appeals from the Commissioner of Patents is limited to two classes of decisions, namely, a *final* rejection of an application for a patent, and a *final* award of priority to one of the parties in an interference case" (italics supplied).

The rule in *inter partes* cases is well illustrated in *Allen v. U. S. ex rel. Lowry*, 26 App. D. C. 8, 18, a quotation from which appears on page 5 of the accompanying petition for the writ of certiorari. This was followed by the Court of Appeals for the Third Circuit in *Synthetic Plastics Co. v. Ellis-Foster Co.*, *supra*.

In *ex parte* cases, similarly, the District Court has not heretofore entertained jurisdiction until there has been a *final* decision in the Patent Office upon the *whole merits* of the case.

- a. The Jurisdiction of the District Court under Section 4915 of the Revised Statutes.

As the Court of Appeals correctly understands (R. p. 582), Section 4915 reads:

“Whenever a *patent* on application is refused by the Board of Appeals \* \* \* the applicant \* \* \* may have remedy by bill in equity \* \* \*”.

It does not read,

“Whenever a *claim* of a patent on application is refused \* \* \*”

Section 4915 of the Revised Statutes does not provide that a District Court, under its provisions, may adjudge that the applicant is entitled

“to receive a patent for his invention, as specified in *any claim*”.

It reads rather:

“as specified in *his claim*”.

The language “his claim”, in the statute, has repeatedly been construed to mean *all the claims*, not merely “any claim”, Seymour v. Osborne, 11 Wall 516, 546; Merrill v. Yeomans, 94 U. S. 568.

According to the provisions of Section 4915 of the Revised Statutes, therefore, an applicant may file a complaint asking the District Court to authorize the Commissioner of Patents to grant him a patent for *his invention*, as specified in *all the claims* of his application. He may not sue, under the provisions of Section 4915, in response to separate rejections, one claim at a time.

The Patent Office itself has heretofore construed the statute in this way. In *ex parte* King, 366 O. G. 3, reproduced in the Appendix, p. 31 *infra*, it appeared that the Board of Appeals, although disposing finally of most of the claims on appeal before it, raised new grounds of rejection as against one only of the appealed claims. It became necessary, therefore, to remand the application to the primary examiner for consideration as to the new grounds of rejection.

If the decision of the Court of Appeals in the present case is sound, therefore, the applicant, in that case, should have appealed promptly to the Court without waiting for a final decision upon the whole merits. Acting Commissioner Kinnan, however, ruled distinctly that, in a case of that kind,

“\* \* \* the decision of the Board can and should be regarded as not a final decision in the case.

If, after the Examiner has considered the new grounds of rejection and any amendment seeking to avoid them, the case again is before the Board, on further appeal, a final decision on all the appealed claims can be rendered.”

Acting Commissioner Kinnan continued:

“This practice appears necessary, since otherwise the applicant would be forced either to abandon his right to go back to the Examiner or to take the case to the court without an issue having been reached as to part of the appealed claims.”

Under the reasoning of Acting Commissioner Kinnan, the Patent Office 1941 piecemeal rejection of the static-inverter claims 74 and 76 to 81 only was not a final decision on the whole merits.

b. The Jurisdiction of the Court of Customs and Patent Appeals under Section 4911 of the Revised Statutes.

The Court of Customs and Patent Appeals has the same jurisdiction over appeals from the Patent Office that the Court of Appeals of the District of Columbia used to have, and under the same statute, *Headley & Thompson v. Bridges*, 48 F. 2d 938, 941, *Sinko Tool & Manufacturing Co. v. Automatic Devices Corporation*, 136 F. 2d 186, 190, and the remedies obtainable under the provisions of Sections 4911 and 4915 of the Revised Statutes are coextensive, *Pitman v. Coe*, 62 App. D. C. 365, 68 F. 2d 412, 414.

The Court of Customs and Patent Appeals, under the provisions of Section 4911 of the Revised Statutes, therefore, refuses to entertain jurisdiction of an appeal from the Patent Office, except after a decision upon the whole merits.

*In re Rundell*, 55 F. 2d 450, 454, a case arising in the Court of Customs and Patent Appeals, for example, even the dissenting opinion recognized that

"If the order \* \* \* is an interlocutory order, the rule is well established that we have no jurisdiction to entertain an appeal from it. This rule is so well established that it needs no citation of authority to support it."

**G. *Hoover Company v. Coe*, 325 U. S. 79, Has Not Changed the Law That an Applicant For Patent May Not Appeal Piecemeal.**

It is now in order to study the Hoover decisions, both in the Court of Appeals and this Court.

In that case, the Court of Appeals had considered the question whether one could proceed under the provisions of Section 4915 of the Revised Statutes in a situation where there had actually been a *final* decision by the Patent Office upon *all* the claims in controversy, but where, nevertheless, there still remained something further to be done before the plaintiff could get his patent; namely, in that case, to declare an interference. In the language of the Court,

"Turning now to the cases we find an explicit ruling by the Supreme Court that a proceeding under Section 4915, R. S. cannot select a single issue which affects plaintiff's right to a patent, without determining all the other issues on which that right depends \* \* \*."

In a footnote, the Court referred to *Butterworth v. Hoe*, 112 U. S. 50, in which

“it was indicated that the record in a suit under Section 4915, R. S. should include the *whole merits* of the applicant’s right to a patent” (*Italics supplied*).

The Court of Appeals of the District of Columbia considered that, since there still remained the possibility of declaring an interference in that case, it could not take jurisdiction, page 516:

“Since the court can not decide the whole controversy on its merits we have no jurisdiction over the intermediate proceedings in the Patent Office.”

This Court, *Hoover Company v. Coe*, 325 U. S. 79, 82, re-stated this principle in the following words:

The court below held that in conformity to the general rule, a court of equity ought not to afford piecemeal relief pending completion of the administrative process, and consequently ought not to entertain a suit under the statute unless its adjudication would conclude all possible questions to the right to a patent.”

This Court appeared fully to approve the principle, however, as to piecemeal appeals. The reversal was based rather upon the ground that the principle had been misapplied by the Court of Appeals, p. 90:

“The ruling of the Board of Appeals in the instant case was neither a procedural ruling nor an interlocutory one as to which the District Court should not entertain a suit under R. S. 4915. On the contrary, it finally denied a patent on the claims presented. In this respect it was like a dismissal of a suit in a court.”

In the present case, the 1941 piecemeal decision of the Board of Appeals of the Patent Office did *not* involve *all* the claims in controversy. It was a piecemeal decision involving the static-inverter claims 74 and 76 to 81 only. Had the law in 1941 permitted an appeal at that time as to the



static-inverter claims 74 and 76 to 81, it would have become necessary to enter a further appeal as to claim 222 in 1945.

The piecemeal decision of 1941, therefore, was actually an interlocutory decision only. It was not even comparable to "a dismissal of a suit in a court". It was comparable rather to a dismissal of part only of a suit. A litigant may not appeal after dismissal of part only of the matters involved in a suit. He must wait until the whole merits have been disposed of.

## VII. Conclusion

According to the practice in force in 1941, it was not permissible at that time to invoke either Section 4911 or 4915 of the Revised Statutes, since the piecemeal decision relating to the static-inverter claims 74 and 76 to 81 was *not* a final decision upon the whole merits, *ex parte* King, page 27, *supra*, and Cosper V. Gold, page 25 *supra*. It is believed that this Honorable Court's decision in the Hoover case has not overruled these cases.

It is respectfully submitted, therefore, that this Court should take jurisdiction of this case, grant the writ of certiorari, reverse the judgment of the Court of Appeals for the District of Columbia, and direct that a new judgment be entered by the District Court authorizing the Commissioner of Patents to issue a patent to your petitioner including the static-inverter claims 74 and 76 to 81.

Respectfully submitted,

DAVID RINES,  
*Attorney for Petitioner.*

Frank W. Dahn,  
*Of Counsel.*



## APPENDIX

*Ex Parte King*

Official Gazette of the United States Patent Office,

Volume 366, January 1928, Page 3.

Decided December 15, 1927.

1. APPEALS—ADDITIONAL REFERENCES CITED BY BOARD—  
RULE 139—PRACTICE.

Where the Board of Appeals, in affirming the rejection of the Examiner, cited additional references against some of the claims, Held that, under the provisions of rule 139, applicant is entitled to amend or present a showing of facts before the Primary Examiner.

2. SAME—SAME—SAME—SAME.

Where the applicant elects to prosecute the case before the Examiner, in an attempt to avoid the rejection brought out in the decision of the Board as to some of the claims held unpatentable, Held that *the decision of the Board can, and should be, regarded as not a final decision.*

3. SAME—SAME—SAME—SAME.

Where the additional references cited by the Board apply only to some of the claims and the applicant elects to prosecute the case further before the Examiner, Held that when the prosecution is concluded before the Examiner the case should be called by the latter to the attention of the Board, unless applicant appeals from a further final rejection.

4. SAME—SAME—TIME FOR FILING RESPONSE BEFORE EX-  
AMINER.

Since a statement by the Board of additional grounds for refusing a patent stands, under the provisions of

rule 139, as a rejection, applicant has the statutory period of six months within which to respond.

ON PETITION.

Application for patent for kitchen furniture.

Mr. Donald H. Sweet for the applicant.

KINNAN, Acting Commissioner:

Applicant petitions that this case be remanded to the Primary Examiner for further consideration, in view of the statement contained in the decision of the Board of Appeals that certain claims are unpatentable over newly-discovered references cited by that tribunal.

The decision was rendered on June 30, 1927, affirming the action of the Examiner as to all the appealed claims. In this decision *the Board of Appeals cited two additional references against one only of such appealed claims*, one reference being specifically applied to this claim. In response to applicant's petition that the case be remanded, in view of such citation, to the Primary Examiner, the Board of Appeals in a decision rendered June 28, 1927, a copy of which apparently was not mailed to the applicant until September 2, 1927, stated that the citation of one of these references was such as to entitle the applicant to amend, but the citation of the other was not, since it was only used as an illustration of the argument made in response to that of applicant. The Board set 30 days within which amendment might be presented with reference to claim 4, that being the particular claim in question.

An applicant is entitled to be heard in connection with any new reference or reason presented in denying his claim of invention. To this end rule 139, as revised July 28, 1927, provides that the Board of Appeals, if it discovers any ground other than that involved in the appeal for refusing a patent, shall so state in its decision and that this statement will reopen the case for amendment or showing of facts before the Primary Examiner responsive thereto and shall be binding upon the Examiner, unless the showing is sufficient to over-

come the additional ground for rejection. The rule further provides that the applicant may waive his right to have the case reconsidered by the Primary Examiner and either ask for reconsideration by the Board of Appeals or treat the decision, including the added ground for rejection, as a final decision in the case.

In view of the fact that an appeal lies directly from the decision of the Board of Appeals to the Court of Appeals of the District of Columbia and that, under the rules of that court, such an appeal must be taken within 40 days after the decision, it would seem that, where the applicant elects to go back to the Primary Examiner, *the decision of the Board can and should be regarded as not a final decision in the case.*

If, after the Examiner has considered the new grounds of rejection and any amendment seeking to avoid them, the case again is before the Board on further appeal, *a final decision on all the appealed claims can be rendered.* So far as those claims are concerned, with regard to which the decision of the Examiner denying them was previously affirmed without citation of new references or reasons, the Board may merely state that it adheres to its original ruling.

As to the other claims if the applicant has convinced the Examiner of their allowability over all grounds of rejection including those added by the Board it would then seem only necessary to call the Board's attention to this fact.

Should the Examiner still hold the claims denied by the Board on new grounds unpatentable after argument or amendment, he should, whenever the case is again appealed and such claims are included in the appeal, furnish an additional statement of his reasons for denial of those claims. This practice appears necessary, since *otherwise the applicant would be forced either to abandon his right to go back to the Examiner or to take the case to the court without an issue having been reached as to part of the appealed claims.*

It is evident, under the rule, that the statement made by the Board of Appeals is to be regarded as a rejection because the rule provides that the applicant

may respond thereto either by amendment or a showing of facts. This should include the right to respond as to any and every reference deemed by the Board as of sufficient importance to be added in support of its new grounds of rejection.

It is, under the settled procedure, not necessary for the Examiner to take any action following the Board's decision in which the statement of further grounds of rejection is included until response has been made by the applicant. This being so, it would seem that the applicant, if he elects to have the case remanded to the Primary Examiner, would have a right to respond thereto at any time within the statutory six months from the date of the decision of the Board of Appeals.

It is noted in this case that the Board's decision was rendered June 30, 1927, and therefore the time for response before the Primary Examiner will expire December 30, 1927.

The petition is granted to the extent indicated. (Italics supplied.)

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CLERK

**Supreme Court of the United States**

**October Term, 1947**

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**No. 652**  
\_\_\_\_\_

**HAROLD E. EDGERTON,**

*Petitioner,*

*vs.*

**LAWRENCE C. KINGSLAND, Commissioner  
of Patents,**

*Respondent.*

\_\_\_\_\_  
**PETITION FOR A WRIT OF CERTIORARI TO THE  
UNITED STATES COURT OF APPEALS FOR  
THE DISTRICT OF COLUMBIA**

\_\_\_\_\_  
**REPLY BRIEF FOR THE PETITIONER.**

\_\_\_\_\_  
✓  
**DAVID RINES,**  
*Attorney for Petitioner.*

✓  
**FRANK W. DAHN,**  
*Of Counsel.*



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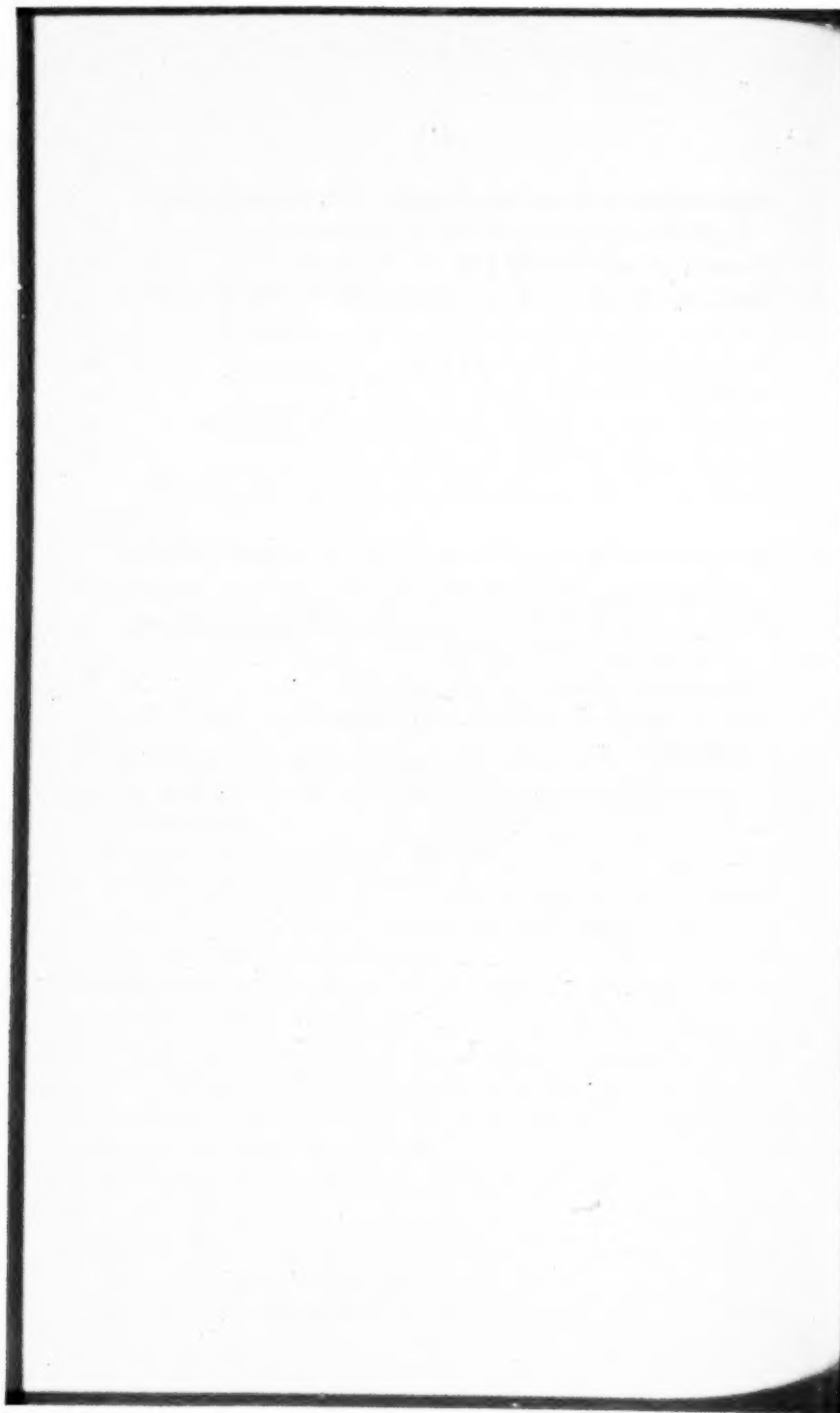
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# Supreme Court of the United States

October Term, 1947

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No. 652

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HAROLD E. EDGERTON,

*Petitioner,*

*vs.*

LAWRENCE C. KINGSLAND, Commissioner  
of Patents,

*Respondent.*

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PETITION FOR A WRIT OF CERTIORARI TO THE UNITED  
STATES COURT OF APPEALS FOR THE DISTRICT  
OF COLUMBIA

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## REPLY BRIEF FOR THE PETITIONER

### INTRODUCTION

The brief accompanying the petition had explained that, in refusing to entertain piecemeal appeals from lower courts, this Court and the Courts of Appeals were but complying with the requirements of legislation enacted by "Congress from the very beginning" (Pet. 17); and that "This carries out a federal policy going back to the early days of the Republic" (Pet. 18), a policy, moreover, that "was only declaratory of a well settled and ancient rule of English practice" (Pet. 17). The brief had further made clear that, partly as (Pet. 24)

“an aspect of the procedural philosophy pertaining to the federal courts whereby, ever since the Judiciary Act, Congress has been loath to authorize review of interim steps in a proceeding,”

the same policy has been in force in connection with piecemeal appeals from administrative bodies. Since the Patent Office is an administrative body (Pet. 24), this policy must naturally apply also to appeals from the Patent Office. The brief further demonstrated that Section 4915 of the Revised Statutes had accordingly never heretofore been permitted to be invoked until after a *final* decision by the Patent Office upon the *whole merits* of the patent application.

The only rulings to the contrary, it seems, that have ever been made by either the Patent Office or any court were the rulings in the case at bar, and the Court of Appeals for the District of Columbia frankly cited as its only authority the holdings of this Court in *Hoover Co. v. Coe*, 325 U. S. 79 (Pet. at the very bottom of page 3).

#### **I. “The sole question presented by the petition.”**

The petition (Pet. 2) had therefore presented the following question, of great public importance (Pet. 4, 5):

“The question presented, therefore, is whether, from now on, contrary to the practice heretofore prevailing, it will be necessary for a patent applicant to resort to the District Court piecemeal upon each and every separate occasion that the Patent Office may render a separate decision involving one or more separate claims of the patent application.”

On page 5, the respondent appears to agree that this is “The sole question presented by the petition.”

The respondent (page 5) accepts

“the general rule that the piecemeal disposition on appeal of a single controversy is not permissible (Pet. 15-24)”,

and he agrees that the present petition deals with such a "single controversy" (Pet. 18 to 22). He appears, furthermore, not to question the petitioner's demonstration that, in construing Section 4915 of the Revised Statutes,

1. This very court, in *Butterworth v. Hoe*, 112 U. S. 50, had (Pet. 29)

"indicated that the record in a suit under Section 4915, R. S. should include the *whole merits* of the applicant's right to a patent" (*italics supplied*);

2. The Court of Appeals of the District of Columbia, as in *Cosper v. Gold*, 34 App. D. C. 194, 197, had (Pet. 25)

"had occasion heretofore to call attention to the fact that the jurisdiction of this court to entertain appeals from the Commissioner of Patents is limited to two classes of decisions, namely,"

*ex parte* cases, like the case at bar, and *inter partes* cases, involving interferences, and that, in *ex parte* cases,

"the jurisdiction of this court \* \* \* is limited to \* \* \* a *final* rejection of an *application* for patent (*italics supplied*),

and not merely, as the respondent argues, below the middle of page 5, on page 6, line 4, on page 10, line 3, and elsewhere, a rejection of "any claim," "any individual claim" or "any one" of the claims of the application for patent;

3. The Court of Customs and Patent Appeals is in full agreement with the Court of Appeals of the District of Columbia, both with regard to *ex parte* cases (Pet. 28), in *re Rundell*, 55 F. 2d 450, 454 (though the respondent, page 8, appears to dispute the petitioner's understanding of this decision), and, as demonstrated by the decisions cited at the bottom of page 27 of the petition, in *inter partes* cases also; and

4. The Commissioner of Patents, at one time, at least, was also in agreement, *ex parte* King, 336 O. G. 3 (Pet. 26, 27).

The respondent appears, however, to argue somewhat as follows:

1. Though he appears not to dispute that the decision of this Court, in *Butterworth v. Hoe supra*, is in accordance with (page 5)

“the general rule that the piecemeal disposition on appeal of a single controversy is not permissible (Pet. 15-24)”,

he apparently considers that this Court has established an exception to this “general rule” in *Hoover Co. v. Coe, supra*, “the full significance” of which, the respondent says (bottom of page 7), the petitioner has “failed to grasp”.

2. From page 6 of his brief, it would appear that the respondent is prepared to agree that, prior to the decision of this Court in the *Hoover Co. case, supra*, and even up to the time of its own decision in that case (144 F. 2d 514), the Court of Appeals of the District of Columbia was still following the practice of *Cosper v. Gold, supra*, relating to

“piecemeal relief pending completion of the administrative process and therefore ought not to entertain a suit under the R. S. 4915 unless its adjudication would conclude all possible questions as to the right to a patent,”

not merely (p. 3, *supra*) the right to “any claim”, “any individual claim” or “any one” of the claims of the application for the patent.

3. The respondent argues (page 8), however, that since, in accordance with three of its decisions, the Court of Customs and Patent Appeals heretofore

"has entertained appeals in cases in which all claims had not been finally disposed of in the Patent Office," under the provisions of Section 4911 of the Revised Statutes,

"it follows that the rejection of *any claim* in a patent application gives the applicant a right to a judicial determination on a bill in equity" (italics supplied) in the District Court, under the provisions of Section 4915 of the Revised Statutes.

4. As for the decision of the Commissioner of Patents, in *ex parte King*, 336 O. G. 3, *supra*, the respondent argues (page 8) that it

"purports to be no more than a construction of the Patent Office's Rule 139;"

that, in any event, it was a decision rendered in 1927; and that

"that construction had obviously been changed in 1941."

5. The respondent argues also (pages 9 and 10) that the words,

"his claim *or for any part thereof*" (italics the respondent's)

in Section 4915 of the Revised Statutes

"indicates that the controversy presented may be the validity of only a part of the subject matter of the entire application,"

a conclusion for which he finds reinforcement (page 8) in Section 4909 of the Revised Statutes.

## II. The "academic" question raised by the respondent.

Though, it is believed, this fairly summarizes the contentions of the petitioner and the respondent relating to what the respondent himself terms "The sole question presented by the petition", the respondent nevertheless raises also a



further question, additional to this "sole question", namely (page 5),

" \* \* \* that, in any event, the petitioner has failed to show that the rejection of his static inverter claims by the primary examiner, the Board of Appeals, and the District Court was clearly erroneous."

In view of this additional question, the respondent says that (page 10)

"the question of the correct interpretation of R. S. 4915 is academic, as petitioner has made no showing that he is entitled to relief on the merits."

In order to demonstrate that "the correct interpretation of R. S. 4915" is *not* "academic", it now becomes necessary to discuss several matters that, in the interest of brevity, were not even mentioned in the petition.

### **III. Facts upon which the petitioner and the respondent appear to be agreed.**

The petitioner and the respondent appear to agree upon quite a number of matters of fact. Among these (Pet. 6 to 8) are that, during the pendency of the petitioner's application, the Patent Office, without interference previously declared, had inadvertently issued to a predecessor of the Cities Service Oil Co. a patent containing the static-inverter claims 74 and 76 to 81 involved on this petition; that, at the petitioner's instance, Interference 74,402 was thereupon belatedly declared between this patent and the petitioner's application; and that this interference was later dissolved upon the ground that the petitioner's application (Respondent's brief, page 3)

"has not disclosed a 'static inverter' as required by claims 74 and 76-71 \* \* \* (R. 259)."

The respondent further appears not to dispute the petitioner's statement that the Patent Office did not at that time

actually know what is a static inverter, and that it nevertheless refused to accept any evidence demonstrating that the holding that the petitioner's application does not disclose a static inverter was contrary to scientific fact (Pet. 8). As in *Sinko Tool & Manufacturing Co. v. Automatic Devices Corporation*, 157 F. 2d 974, 978, the Patent Office considered itself to be "endued", in Judge Learned Hand's words,

"with that specialized acquaintance with the subject matter which enables it to dispense with evidence and draw upon undisclosed sources of information, not available to us and unknown to the parties."

It appears to be also agreed that, since the decision dissolving the interference was not a final decision upon the whole merits, the petitioner was at that time without remedy to obtain a court review of the holding that the petitioner's application does not disclose a static inverter; and this either in the District Court, under the provisions of Section 4915 of the Revised Statutes, or in the Court of Customs and Patent Appeals, under the provisions of Section 4911 of the Revised Statutes. It appears to be further agreed that, as a preliminary to such court review, it became necessary for the petitioner (again at his own instance, R. 257) to resume the *ex parte* prosecution of the application, in order to obtain an adjudication of the remaining claims of the application (Pet. 8 and 9); but that this *ex parte* prosecution resulted, in 1941, in only a piecemeal decision by the Patent Office relating to the static-inverter claims 74 and 76 to 81 only, still without any final decision upon the whole merits (Pet. 9).

At this point, the respondent's brief (page 5) contends that, notwithstanding the fact that there had not, as yet, been any final decision in the Patent Office upon the whole merits, the Court of Appeals of the District of Columbia has never-

theless "properly applied the decision of this Court in *Hoover Co. v. Coe*", *supra*, in that it "correctly interpreted R. S. 4915" as requiring that the petitioner should have filed his complaint within six months of that 1941 piece-meal decision (page 8 of the respondent's brief)

"without the necessity of waiting until there had been a final disposition of all claims."

There are several further matters of fact upon which the petitioner and the respondent appear to be agreed. At the time of the later final action upon the whole merits of the petitioner's application, in 1945, the Patent Office withdrew entirely from its original holding that the petitioner's application does not disclose a static inverter. That original holding, upon the basis of which the interference had been dissolved, was therefore completely abandoned and, as appears from page 4 of the respondent's brief, a new ground of rejection was offered, instead, namely,

"that the previous final rejection of them [the static-inverter claims 74 and 76 to 81] was *res judicata* as the time for further appeal had expired (R. 286, 500)."

It is desired to emphasize that that new ground became now the *sole* ground of rejection (R. 513, 518, 523). The Patent Office made no further attempt to justify its original erroneous holding, contrary to scientific fact, that the petitioner's application does not disclose a static inverter. It may be of significance to add that the Patent Office had meantime had access to the *inter partes* testimony in *Cities Service Oil Co. v. Edgerton*, 56 F. Supp. 294 (R. 513, 523).

It appears to be also agreed, however, that the District Court, unlike the Patent Office, was not content to base its rulings upon the ground of *res judicata* alone. On the contrary, the District Court considered it to be wise to attempt to strengthen its holding as to *res judicata* by resurrecting

the rejection, already dead in the Patent Office itself, upon the ground that the petitioner's application does not disclose a static inverter. As the opening sentence of the respondent's brief admits, the District Court did not, however, write any opinion explaining why the petitioner's application does not disclose a static inverter. The District Court did not, as a matter of fact, even mention the term "static inverter". In the language at the bottom of page 10 of the respondent's brief, the District Court considered it to be sufficient to rule only that

"the disclosure in the application did not support any of the claims here involved."

It is likewise agreed that the Court of Appeals was apparently not so satisfied as was the District Court about the advisability of reviving this previously dead issue (page 5 of the respondent's brief):

"On appeal the Court of Appeals for the District of Columbia considered it necessary to discuss only the *res judicata* question, and affirmed the District Court on that ground on the authority of this Court's decision in *Hoover Co. v. Coe*, 325 U. S. 79, which was deemed to be controlling (R. 582-583, 586)."

It is therefore further agreed that the petitioner has never had a ruling from the Court of Appeals as to whether the Patent Office was wrong in burying, and the District Court was therefore right in resurrecting, the rejection upon the ground that the petitioner's application does not disclose a static inverter.

It is in order, therefore, to discuss two questions in this reply brief: one, the question that the respondent admits is "The sole question presented by the petition"; and secondly, the "academic" question raised by the respondent. These will be treated in inverse order.

## SUMMARY OF ARGUMENT

**I. The question newly raised by the respondent is not "academic".**

**II. As for "the sole question raised by the petition",**

1. The practice with regard to piecemeal appeals heretofore in force in

A. This Court,

B. The Court of Appeals of the District of Columbia,

C. The Court of Customs and Patent Appeals, and

D. The Patent Office

has not been revolutionized; for

E. *Hoover Co. v. Coe*, 325 U. S. 79, has not changed this practice.

2. The words "his claim or for any part thereof" in Section 4915 of the Revised Statutes relate to the relief that the District Court may give, and not to its jurisdiction.

3. The different language employed in Sections 4909 and 4915 of the Revised Statutes serves but to emphasize that a suit under Section 4915 of the Revised Statutes may not be filed until after a final decision upon the whole merits.

## ARGUMENT

**I. The question newly raised by the respondent is not "academic".**

After admitting (page 5), as before stated, that the Court of Appeals declined to approve the District Court's ruling that the disclosure of the petitioner's application does not support the static-inverter claims 74 and 76 to 81

involved on this appeal, the respondent presents the argument that (pages 10, 11)

“the question of the correct interpretation of R. S. 4915 is academic”,

because

“Although this ground of decision was not considered by the court below on the appeal, in the review of proceedings under R. S. 4915 that court has consistently applied the well-established rule that findings of fact of the trial court will not be disturbed unless clearly erroneous or without support in the evidence. \* \* \* This rule has peculiar force where, as here, the contested finding has been concurred in by both the Patent Office and the District Court.”

There are at least five fallacies in this argument.

First, in the present instance, it appears to be agreed (p. 9, *supra*) that the Court of Appeals has thus far refused either to disturb or not to disturb any “findings of fact of the trial court.” The one matter relating to *res judicata* decided by the Court of Appeals relates to a conclusion of law, and not any “findings of fact.”

Secondly, it appears also to be agreed, as already stated, (p. 9, *supra*), that there have never been any “findings of fact of the trial court” to the effect that the petitioner’s application does not disclose a static inverter. The exact rulings of the District Court were (R. 29):

“4. The plaintiff’s application here involved does not contain a disclosure which will support any of claims 74, 76 to 81, inclusive, and 222 of his application here involved.

5. The plaintiff is not entitled to make any of the claims 74, 76 to 81, inclusive, and 222 of his application here involved.”

These fourth and fifth findings of alleged fact clearly do not constitute a holding to the effect that the petitioner’s application does not disclose a static inverter. They say no more than does the second conclusion of law (R. 29):

"2. The plaintiff is not entitled to any claims set forth in the complaint."

They do not present any "findings of fact of the trial court" whatever, not even a finding of "underlying fact", as required in *Schneiderman v. United States*, 320 U. S. 118, 129:

"The pertinent findings of fact on these points, set forth in the margin, are but the most general conclusions of ultimate fact. It is impossible to tell from them upon what underlying facts the court relied, and whether proper statutory standards were observed."

This may explain why the Court of Appeals preferred to base its ruling upon the ground of *res judicata* alone.

Thirdly, there cannot have been any "concurrence" in any "findings of fact of the trial court" to the effect that the petitioner's application does not disclose a static inverter because the trial Court, as already explained, p. 9, *supra*, never made either that or any other "findings of fact" relating to the static inverter. But even if there had been any "findings of fact of the trial court", instead of a mere conclusion of law, and even if those "findings of fact of the trial court" had constituted findings to the effect that the petitioner's application does not disclose a static inverter, there still could not have been any "concurrence," because the Patent Office had by that time itself abandoned that erroneous ground of rejection.

As for the fourth fallacy in the respondent's newly presented argument relating to "The sole question presented by the petition" being "academic", the Court of Appeals has thus far refused to hold that the fourth and fifth findings of alleged fact of the District Court were or were not "clearly erroneous."

And fifthly, the Court of Appeals has similarly thus far refused to hold that these fourth and fifth findings of alleged facts were or were not "without support in the evi-



dence". In a footnote on page 3, on the contrary, the respondent himself refers to some of the uncontradicted testimony of witnesses of unimpeachable character in the District Court (testimony which the petitioner was not permitted to present before the Patent Office, Pet. 8) proving conclusively that the petitioner's application does disclose a static inverter. There is not the slightest evidence to the contrary; not even the "mere scintilla" referred to by this Court in *Consolidated Edison Co. v. National Labor Relations Board*, 305 U. S. 197, 229, and *National Labor Relations Board v. Columbian Enameling & Stamping Co.*, 306 U. S. 292, 300, let alone the "substantial evidence" required by these decisions.

## II. "The sole question raised by the petition".

### 1. *The Practice With Regard To Piecemeal Appeals Heretofore In Force Has Not Been Revolutionized.*

#### A. The Law As To Piecemeal Appeals In This Court.

The views of the petitioner and the respondent have been stated on pages 3 and 4, *supra*.

#### B. The Law As To Piecemeal Appeals In The Court of Appeals of the District of Columbia.

The views of the petitioner and the respondent have been stated on pages 3 and 4, *supra*. In view of some of the respondent's arguments, however, it is desired to invite attention to the fact stated in *re Hien*, 166 U. S. 432, 439, that

"The bill in equity provided for by Section 4915 is wholly different from the proceeding by appeal from the decision of the Commissioner under consideration



in this case. The one is the exercise of original, the other, of appellate, jurisdiction."

C. The Law As to Piecemeal Appeals in the Court of Customs and Patent Appeals.

In support of his thesis that the Court of Customs and Patent Appeals will entertain jurisdiction of piecemeal appeals under the provisions of Section 4911 of the Revised Statutes, the respondent, as before stated, cites three decisions.

*In re Gillam*, 37 F. 2d 959, 960, the Court of Customs and Patent Appeals held that, once it had obtained jurisdiction by the perfecting of an appeal from a final decision of the Patent Office upon the whole merits, that jurisdiction could not thereafter be ousted merely by its being

"*brought to our attention by counsel for the appellant that, since the present appeal was perfected, the Patent Office has permitted the filing of amended claims herein, and has caused certain interference issues to be made up between this application, as amended, and a certain other application*" (italics supplied).

The Court of Customs and Patent Appeals adhered to this ruling *in re Robertshaw*, 75 F. 2d 203, following the precedent established in *Roemer v. Simon*, 91 U. S. 149, reaffirmed in *Realty Acceptance Corp. v. Montgomery*, 284 U. S. 547, 551.

As for *in re Rundell*, 55 F. 2d 450, the petitioner has already explained (Pet. 28) that even the dissenting opinion was opposed to the view contended for by the respondent.

In that case, the Patent Office had held that an applicant for a patent, in a single application, had presented two sets of claims directed to two separate and distinct inventions.

The claims of one set covered a complete machine for crimping plastic caps on bottles. The claims of the other set covered a part only of the machine, a sub-combination involving a crimping die or head.

The Patent Office required "division", or an election as to which of the two inventions was to be prosecuted in the one application; and the Court of Customs and Patent Appeals held that Section 4911 of the Revised Statutes conferred jurisdiction to entertain an appeal from a decision of the Patent Office requiring such division.

The Court of Appeals of the District of Columbia is in accord with the Court of Customs and Patent Appeals that a decision requiring division is final, *Pitman v. Coe*, 68 F. 2d 412. So is this Court, *Steinmetz v. Allen*, 192 U. S. 543, 556:

"True, a distinction can be made between his ruling and one on the merits, if we regard the merits to mean invention, novelty or the like. But in what situation would an applicant for a patent be? If he yield to the rule he gives up his right of joinder. If he does not yield he will not be heard at all, and may subsequently be regarded as having abandoned his application. See 4894, Rev. Stat. A ruling having such effect must be considered as *final and appealable*" (italics supplied).

Not one of the three decisions cited by the respondent, therefore, supports the proposition that the Court of Customs and Patent Appeals will take jurisdiction of an appeal from the Patent Office prior to a final decision upon the whole merits.

That the Patent Office itself has heretofore understood that the Court of Customs and Patent Appeals will not entertain appeals from piecemeal decisions of the Patent Office is evident from *ex parte King*, 336 O. G. 3 *supra*. On page 8, the respondent says that, in this decision, Acting

Commissioner of Patents Kinnan was only construing Rule 139 of the Rules of Practice of the Patent Office (quoted in the Appendix), and not either Section 4911 or Section 4915 of the Revised Statutes.

Quite true. But that construction of Rule 139 was admittedly based upon, so as to be in harmony with, the previous construction of the Court of Appeals of the District of Columbia of Section 4911 of the Revised Statutes (Pet. 33, the first complete paragraph). The Courts of Appeals of the District of Columbia and the Second Circuit and the Court of Customs and Patent Appeals are agreed as to this construction of Section 4911 of the Revised Statutes (Pet., bottom of page 27).

Commissioner Kinnan ordered that the application be remanded to the Primary Examiner in order that final action upon all the claims (*the whole merits*) might be obtained prior to compelling the applicant to appeal to the Court. If he had not done so, as Commissioner Kinnan himself explained (Pet. 33), the case would have come into

“the court without an issue having been reached as to part of the appealed claims,”

and the Court would then have refused to take jurisdiction upon the ground that the decision appealed from was not *final upon the whole merits*.

It should now be clear that none of the three decisions cited by the respondent supports his contention that, after the Patent Office piecemeal decision of 1941, the petitioner could have appealed to the Court of Customs and Patent Appeals, under the provisions of Section 4911 of the Revised Statutes.

What is more important, insofar as the present petition is concerned, none of them supports the proposition that the petitioner could at that time have filed suit in the District Court under the provisions of Section 4915 of the Revised Statutes.

D. The Law As To Piecemeal Appeals In The Patent Office.

As explained on page 5, *supra*, the respondent suggests that, in the view of three of the numerous members of the Board of Appeals of the Patent Office, the doctrine *ex parte* King, *supra*, enunciated in 1927 by the head of the Patent Office, was no longer in force in 1941.

These three members of the Board of Appeals could not, however, undertake to speak for the remaining numerous members of that Board, and they could not undertake to overrule the law as to piecemeal appeals (p. 3, *supra*) as laid down by the dictum of this Court, the decisions of the Court of Appeals of the District of Columbia and the Court of Customs and Patent Appeals, or even the 1927 decision of their superior officer, the Commissioner of Patents.

The respondent has not cited any decision, prior to the decision in the case at bar, overruling *ex parte* King, *supra*, whether by the Commissioner of Patents, his subordinate Board of Appeals, or any other tribunal, whether in the Patent Office or any Court.

E. Hoover Co. v. Coe, 325 U. S. 79, Has Not Changed the Practice Relating to Piecemeal Appeals.

Irrespective of what the Court of Appeals of the District of Columbia, the Court of Customs and Patent Appeals and the Patent Office have heretofore decided as to piecemeal appeals, however, "The sole question presented

by the petition herein'', as posed by the respondent himself (page 5), is as to whether this Court, in *Hoover Co. v. Coe, supra*, has revolutionized the practice with respect to piecemeal appeals. It is now in order, therefore, to look into that matter.

By way of background, as stated on page 6 of the respondent's brief, the Patent Office had refused to allow to a reissue applicant certain claims copied from another's patent upon the ground that they did not read on the reissue applicant's disclosure. Without allowing those claims, of course, the Patent Office could not comply with the reissue applicant's request for an interference with that patent.

The reissue applicant, therefore, was compelled to jump two hurdles before he could obtain a reissue patent containing those copied claims: first, to obtain a ruling that the copied claims did read on his disclosure; and secondly, to prove, by testimony in an interference, that he was the prior inventor of the subject matter of those copied claims.

It was impossible, however, for the reissue applicant even to reach the second hurdle until after overcoming the first. The interference with the patent that he asked for could not even be set up until he had first obtained a ruling to the effect that the copied claims did read upon his disclosure.

The reissue applicant proposed to obtain that ruling through the medium of a suit filed in the District Court under the provisions of Section 4915 of the Revised Statutes.

The District Court entertained jurisdiction over the suit. The Court of Appeals of the District of Columbia, 144 F. 2d 514, *supra*, however, dismissed the appeal.

The reason advanced for the dismissal was that, even in the event of a holding favorable to the reissue applicant, the Commissioner of Patents could not have granted the reissue patent; this because there was something further for the Patent Office to do before grant, namely, to declare an interference between the reissue applicant and the patent from which the claims had been copied. The Court of Appeals of the District of Columbia considered that a decree authorizing the Commissioner of Patents to grant a patent, under circumstances where such authorization constituted only a step in further proceedings that might or might not lead ultimately to the grant of the patent, would have afforded only (Respondent's brief, page 6)

"piecemeal relief pending completion of the administrative process."

Under such reasoning, as this Court pointed out on pages 88 and 89 of its decision in *Hoover Co. v. Coe*, *supra*, Section 4915 of the Revised Statutes would have become practically a dead letter. As appears from the very close of its decision, at page 517, indeed, that is precisely what the Court of Appeals tried to bring about.

As appears from Judge Learned Hand's discussion in *Sinko Tool & Manufacturing Co. v. Automatic Devices Corporation*, 136 F. 2d. 186, 190, this was not the first time that the Courts of the District of Columbia had been attempting to abdicate in favor of the Court of Customs and Patent Appeals.

On page 83 of its decision in *Hoover Co. v. Coe*, *supra*, this Court appreciates that an applicant in an *ex parte* case (as distinguished from an *inter partes* interference) is unable to obtain in the Court of Customs and Patent Appeals,

under the provisions of Section 4911 of the Revised Statutes, the kind of review that Congress intended that he should have in the District Court, under the provisions of Section 4915. Under the provisions of Section 4911, in the Court of Customs and Patent Appeals,

“the hearing is summary and solely on the record made in the Patent Office”.

But the petitioner did not want a summary hearing on the record made in the Patent Office. He wanted to present testimony that the Patent Office had refused to receive. Under the provisions of Section 4915 of the Revised Statutes, Congress had enabled the petitioner to present such testimony in the District Court, through the medium of “a formal trial”

“On proof which may include evidence not presented in the Patent Office.”

The real question presented in the Hoover Co. case, *supra*, therefore, was whether an applicant for patent, in an *ex parte* proceeding, shall or shall not be afforded a forum where he may present evidence that the Patent Office refuses to entertain. Congress had intended to answer this question in the affirmative through the enactment of Section 4915 of the Revised Statutes. The Courts of the District of Columbia, on the other hand, had apparently been trying to nullify this Congressional intent.

If the Courts of the District of Columbia are so heavily burdened that they cannot do justice in suits under the provisions of Section 4915 of the Revised Statutes, perhaps legislation should be enacted that will afford an applicant for patent elsewhere than in the District Court the hearing that he cannot obtain in the Patent Office. At the present time, however, the only place where he can obtain this hearing is in the District Court, under the provisions of Section 4915 of the Revised Statutes.



It would appear not to promote the progress of science and useful arts, as provided for in Article 1, Section 8, of the United States Constitution, for the legislative branch of the government to encourage inventors by promising them an opportunity to present their side of the case by testimony, and for the judicial branch of the government then to discourage them by refusing to hear their testimony.

The decision of this Court, in *Hoover Co. v. Coe, supra*, therefore, merely so interpreted Section 4915 of the Revised Statutes as to restore to applicants for patent the opportunity that they had previously always had, and that Congress had always intended that they should have, to present in the District Court testimony that the Patent Office would not hear. In order to effect this result, this Court had to rule that the decision of the Patent Office holding that the copied claims did not read on the reissue applicant's disclosure was a final decision. It might have paraphrased its own previous holding (see p. 15, *supra*) in *Steinmetz v. Allen, supra*:

"True, a distinction can be made \* \* \* if we regard the merits to mean invention, novelty or the like. But in what situation would an applicant for a patent be? If he yield to the ruling of the Court of Appeals of the District of Columbia, he gives up his right to present testimony in the District Court, and he will not be able to obtain a review of the Patent Office decision based upon such testimony. If he does not yield he will not be put into interference with the patent the claims of which he copied for interference purposes and may subsequently be regarded as having abandoned his application."

Unfortunately, however, the decision in *Hoover Co. v. Coe, supra*, has now been construed to have a meaning that, it is believed, this Court never intended that it should have, namely, that the applicant is now compelled to avail him-



self of the opportunity to present his testimony in the District Court following promptly upon every piecemeal decision of the Patent Office adjudicating (page 3, *supra*) "any claim", "any individual claim", or "any one" of the claims of his application for patent.

The respondent says (page 7), first, that there is nothing in the record of the Hoover Co. case

"to indicate that in that case all claims had been disposed of prior to the bringing of the suit;"

and secondly, that

"there is nothing in this Court's opinion to indicate \* \* \* that the final disposition of all claims was considered by this Court as a condition precedent to the bringing of the suit."

With regard to the first of these two arguments, the footnote on page 7 invites attention to the fact that pages 113 to 115 of the record in the Hoover Co. case show that claims 1 to 23 and 34 to 41 were alone acted upon by the primary examiner of the Patent Office on March 28, 1941, and that no action was taken on that date with respect to the remaining claims 24 to 33.

The respondent's brief is signed, among others, by the solicitor and the attorney for the respondent. As the respondent, his solicitor and his attorney naturally all have access to the complete Patent Office record of the Hoover Co. case, they could have informed this Court as to the exact disposition that had previously been made by the primary examiner of these remaining claims 24 to 33; whether, as the footnote puts it, they "had been cancelled or previously rejected, or were still pending".

The petitioner is unable to furnish that information for, in common with other members of the public, he does not have access to that record.

It must be presumed, however, that those claims 24 to 33 had already in some manner been disposed of prior to the date of the said letter of March 28, 1941, so that it was not necessary for the primary examiner to refer to them any longer. It cannot be presumed that the primary examiner had refused arbitrarily to perform his duty of acting upon all the claims of the reissue application, and that the reissue applicant would have acquiesced in such arbitrary refusal.

It is believed, however, that the District Court, the Court of Appeals of the District of Columbia and this Court were all under the impression, whether or not it was an actual fact, that all the claims of the reissue application had been disposed of prior to the bringing of the suit in the District Court. It is believed that all three of these Courts would have refused to entertain jurisdiction of a suit in a case involving only a piecemeal decision in the Patent Office. "On its own motion", 144 F. 2d 514, *supra*, the Court of Appeals would certainly have "raised the question" if it had had the least suspicion that there was any additional reason in support of its holding that (Respondent's brief, page 6).

"a court of equity ought not to afford piecemeal relief pending completion of the administrative process."

Even if it be assumed, therefore, that, in actual fact, the Patent Office did not finally pass upon those remaining claims 24 to 33 prior to the entry of the suit in the District Court, it was merely an oversight that the question of jurisdiction was not raised on the motion of the Court itself. As in *The Baldwin Company v. R. S. Howard Company*, 256 U. S. 35, 40, therefore,

"No question of the jurisdiction of the court was considered in that case, and an inadvertent allowance of the writ of certiorari does not establish the jurisdiction of the court."

The respondent's second argument, that this Court did not

"indicate \* \* \* that the final disposition of all claims was considered by this Court as a condition precedent to the bringing of the suit"

appears to be fully answered on page 90 of this Court's decision:

"The ruling of the Board of Appeals in the instant case was neither a procedural ruling nor an interlocutory one."

It could have been nothing else, therefore, than a final ruling. This second argument appears to be answered further by this Court's comparing the ruling of the Board of Appeals to "a dismissal of a suit in a court". This Court could not have intended to make such a comparison in a case where it could have known that the Board of Appeals had passed upon part only of the claims in controversy. A more consistent comparison would in that event have been with a dismissal of *part only* of a suit in a court (Pet. 30).

It would therefore appear that when this Court, in *Hoover Co. v. Coe*, *supra*, so interpreted Section 4915 of the Revised Statutes as to give full effect to the Congressional intent that an applicant for patent, since he is not allowed to present testimony in the Patent Office, shall be afforded an opportunity to do so in the District Court, it did not mean by that interpretation to revolutionize the practice relating to piecemeal appeals.

2. *The Words "His Claim Or For Any Part Thereof" In Section 4915 Of The Revised Statutes Relate To The Relief That The District Court May Give, And Not To Its Jurisdiction.*

The history on page 9 of the respondent's brief leading up to the establishment of the present-day practice, according

to which a patentee sets forth "his claim" in the form of numbered paragraphs, instead of only a single claiming paragraph, is in full accord with the petitioner's statement (Pet. 26) that "his claim" means *all the claims*, and not merely *any claim*.

On page 469 of Lutz's article referred to by the respondent, in Volume 20 of the Journal of the Patent Office Society, for example, mention is made of the claim of Goodyear's reissue patent No. 156 of 1849 as affording an illustration of the prior practice. This claim is quoted in *Goodyear v. Central R. Co. of N. J.*, 10 Fed. Cas. 5,563, at the bottom of page 665:

"What I *claim* as my invention, and desire to secure by letters patent, is, the curing of caoutchouc or India rubber, by subjecting it to the action of a high degree of artificial heat, substantially as herein described, and for the purposes specified. And I *also claim* the preparing and curing the compound of India rubber, sulphur, and a carbonate or other salt or oxide of lead, by subjecting the same to the action of artificial heat, substantially as herein described" (italics supplied).

This "claim" of Goodyear's reissue patent, however, would still have been "his claim" if it had been in the form of two separate numbered paragraphs, instead of in the form of this single unnumbered paragraph.

Lutz gives also further illustrations, including *Appleton v. Chambers*, 1 Fed. Cas. 497a. At page 1073, the Court said that the patentee, in a single unnumbered paragraph, stated:

"his claim \* \* \* very minutely \* \* \* under eleven heads or divisions."

The "eleven heads or divisions" would still have constituted "his claim" if the patentee had stated them, as under present-day practice, in the form of eleven separately numbered paragraphs.

On this page 1073, the Court also referred to a decision of the Commissioner of Patents allowing a patent

“upon the third and fourth sections of his claim, when he shall have cancelled the two first sections thereof.” Under present-day practice, these four sections of “his claim” would be presented in the form of separately numbered claims 1 to 4, and the Commissioner of Patents would allow claims 3 and 4 and reject claims 1 and 2.

At the top of page 10, the respondent appears not to dispute the fact that, prior to the time when lawyers and judges began to talk in terms of separately numbered paragraphs or claims, this very Court, as in *Seymour v. Osborne*, 11 Wall 516, 546, and *Merrill v. Yeomans*, 94 U. S. 568 (Pet. 26), had construed the expression “his claim” to refer to *all* the claims of a patent. The respondent objects, however, that these two decisions involved suits for patent infringement, and not suits under the provisions of Section 4915 of the Revised Statutes.

The pertinency of this objection is not obvious. In those two cases, this Court was not construing terminology occurring in a statute relating to patent infringement, and the expression “his claim” was not used in connection with the matter of patent infringement. This Court was construing the meaning of a term, “his claim,” that was at that time in common use. The respondent’s objection appears not to throw any light upon the meaning of the term “his claim”; whether, at that time, it meant *any* claim of the patent, or *all* the claims.

In *Seymour v. Osborne*, *supra*, Seymour had obtained an original patent that, as appears from the bottom of page 558 of this Court’s decision, had contained at least two claims. As appears from a footnote on page 518, this original patent was reissued in the form of at least two reissue

patents, Nos. 72 and 1683, each of which, as appears from the top of page 524, contained at least one *claim*. On page 546, this Court referred to

“the specification and *claim*, both in the original and reissued patents” (italics supplied),  
irrespective of whether the patent contained only a single *claim* or several claims.

In *Merrill v. Yeomans*, *supra*, at page 570, similarly, this Court spoke of the “distinct and formal *claim*” that “comes at the close of the schedule or specification.” This Court spoke advisedly of this “claim,” in the singular, notwithstanding that, in the very next breath, it recognized the fact that this “*claim*” was constituted of “two separate claims.”

It is in this sense that the expression “his claim” was, from the very first, used in Section 4915 of the Revised Statutes.

On page 9, however, the respondent says that, since Section 4915 of the Revised Statutes authorizes the District Court to determine whether the

“\* \* \* applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear” (italics the respondent’s),

therefore,

“This indicates that the controversy presented may be the validity of only a part of the subject matter of the entire application.”

It is believed, however, that the respondent is confusing the question of jurisdiction with that relating to what relief the Court may give, once it has acquired jurisdiction.

In former times, when “his claim” was presented in the form of a single unnumbered paragraph, a District Court, like the Commissioner in *Appleton v. Chambers*, page 26, *supra*, might have “adjudged”

“that such applicant is entitled, according to law, to receive a patent for his invention, as specified in” “the third and fourth sections of his claim.” These third and fourth sections would have constituted the “any part thereof,” that is, of “his claim,” as specified in the statute. Under present-day practice, with these four sections of “his claim” in the form of separately numbered paragraphs, the Court would similarly “adjudge” with respect to the “part” of “his claim” involving claims 3 and 4.

A similar provision is found in Section 4918 of the Revised Statutes (U. S. C., title 35, sec. 66):

“Whenever there are interfering patents, any person interested in any one of them, or in the working of the invention claimed under either of them, may have relief against the interfering patentee, and all parties interested under him, by suit in equity against the owners of the interfering patent; and the court, on notice to adverse parties, and other due proceedings had according to the course of equity, may adjudge and declare either or both the patents void *in whole or in part* upon any ground, or inoperative, or invalid *in any particular part* of the United States, *according to the interest of the parties* in the patent or the invention patented. But no such judgment or adjudication shall affect the right of any person except the parties to the suit and those deriving title under them subsequent to the rendition of such judgment” (italics supplied).

The words of Section 4915 of the Revised Statutes, “*or for any part thereof*,” italicized by the respondent, therefore, like the corresponding italicized words of Section 4918 of the Revised Statutes, have nothing whatever to do with jurisdiction. They have rather to do with the nature of the relief that may be “adjudged” by the Court, “as the facts in the case may appear,” once jurisdiction has already been acquired after a *final* decision by the Patent Office upon the *whole merits*.



3. *The Different Language of Sections 4909 and 4915 of the Revised Statutes Serves But to Emphasize That a Suit Under Section 4915 May Not Be Filed Until After a Final Decision Upon the Whole Merits.*

On page 8, the respondent contrasts the wording of Section 4915 of the Revised Statutes, conferring jurisdiction upon the District Court, with Section 4909 of the Revised Statutes, conferring jurisdiction upon the Board of Appeals of the Patent Office. The Board of Appeals, under the provisions of Section 4909 of the Revised Statutes, has jurisdiction to consider

*"any of the claims \* \* \* which have been twice rejected"* (Respondent's italics).

In this Section 4909, therefore, Congress has recognized the fact that, within the Patent Office itself, there are occasions when it is advantageous to permit the Board of Appeals to decide the merits, one claim at a time.

Under the provision of Section 4915 of the Revised Statutes, on the other hand, the District Court does not have jurisdiction

*"Whenever any of the claims of a patent on application is refused by the Board of Appeals."*

It does not, therefore, have jurisdiction to decide the merits, one claim at a time. On the contrary, it has jurisdiction only

*"Whenever a patent on application is refused by the Board of Appeals";*

and its jurisdiction may therefore be invoked only when the Board of Appeals has rendered a *final* decision upon the *whole merits*.

A "final" decision upon the "whole merits," as stated by this Court as long ago as in *Beebe v. Russell*, 19 How. 283, 285 (Pet. 20), is a decision such



“that it will not be necessary to bring the cause again before the court for its final decision.”

Under the construction contended for by the respondent, on the other hand, the cause would be brought before the court again and again, after each piecemeal “rejection of any claim” (Respondent’s brief, page 8).

In the present case, for example, it would have been necessary to file two complaints under the provisions of Section 4915 of the Revised Statutes: one, in 1941, relating to the static-inverter claims 74 and 76 to 81; and the other, in 1945, relating to claim 222.

### CONCLUSION

There appear to be two questions for consideration on this petition: the “sole” question and the “academic” question.

Insofar as the “academic” question is concerned, the uncontradicted, undisputed and unimpeached testimony demonstrates that the petitioner is the prior inventor of the subject matter set forth in the static-inverter claims 74 and 76 to 81. As in *Clements v. Kirby*, 274 F. 575, 577, a technical rule (relating to *res judicata*) has been so applied

“as to divert the patent from the true inventor to another.”

The answer to the “sole” question shows, however, that there is no basis even for applying this technical rule.

According to the dictum of this very Court (p. 4, *supra*), the District Court may not entertain a suit under the provisions of Section 4915 of the Revised Statutes except after a *final* decision upon the *whole* merits.

The Court of Appeals of the District of Columbia had also previously consistently ruled (p. 4, *supra*) that a

District Court may not entertain jurisdiction of a suit under the provisions of Section 4915 of the Revised Statutes except after a *final* rejection of an application.

The respondent appears to be mistaken (pp. 15 to 17, *supra*) in his understanding that the Court of Customs and Patent Appeals will entertain jurisdiction of a piecemeal appeal under Section 4911 of the Revised Statutes.

The respondent has offered no evidence that the Commissioner of Patents has ever overruled his own decision in *ex parte* King, *supra*.

These decisions have all been in accordance with "the general rule," going back to very ancient times, according to which (Respondent's brief, page 5),

"the piecemeal disposition on appeal of a single controversy is not permissible (Pet. 15-24)."

It is believed that this Court, in *Hoover Co. v. Coe*, *supra*, has not intended to revolutionize this ancient practice. It is believed that this Court has not intended to discriminate against applicants for patent by excluding them from the benefits of this "general rule," so as to compel them, from now on, unlike other citizens, to be subjected to the heavy burden of appeal after appeal, every time that the Patent Office may render a separate decision relating to "any individual claim" (Respondent's brief, page 6, line 4). Attention is invited to page 5 of the Petition.

As this Court said, in *United States v. Dubilier Condenser Corp.*, 289 U. S. 178, 186,

"An inventor deprives the public of nothing which it enjoyed before his discovery, but *gives something of value* to the community \* \* \* In consideration of \* \* \* the consequent *benefit to the community*, the patent is granted" (italics supplied).

The patent is thus granted, *Seymour v. Osborne*, *supra*, at page 533,

“as matter of compensation to the inventors for their labor, toil, and expense in making the inventions, and reducing the same to practice for the *public benefit*” (italics supplied).

It is believed that this Court, in *Hoover Co. v. Coe, supra*, has not intended to increase the burdens of these public benefactors. It is believed, on the contrary, that this Court has tried to aid them. It has tried to carry into effect the Congressional intent, as expressed in Section 4915 of the Revised Statutes. It has tried to restore to inventors the opportunity that they had previously had, but which had been taken away by the lower-court decision in the *Hoover Co.* case, of presenting in the District Court testimony that the Patent Office will not accept.

It is therefore respectfully submitted that the petition for the writ of certiorari should be granted.

Respectfully submitted,

DAVID RINES,  
*Attorney for Petitioner.*

FRANK W. DAHN,  
*Of Counsel.*

## APPENDIX

Rule 139 of the Rules of Practice in the United States  
Patent Office

"139. The board of appeals in its decision shall affirm or reverse the decision of the primary examiner only on the points on which appeal shall have been taken. (See rule 133.) *Should it discover any apparent grounds not involved in the appeal for granting or refusing letters patent in the form claimed, or in any other form, it shall include in its decision a statement to that effect with its reasons for so holding.*

*This statement of the board of appeals, if adverse to applicant's right to a patent, will reopen the case for amendment or showing of facts, or both, before the primary examiner responsive thereto. The statement shall be binding upon the primary examiner unless an amendment or showing of facts not previously of record be made which, in the opinion of the primary examiner, avoids the additional grounds for refusal of the patent stated in the decision.*

The applicant may waive the right to further prosecution before the primary examiner and have the case reconsidered by the board of appeals upon the same record. Where request for such reconsideration is made the board of appeals shall render a new decision which shall include *all grounds upon which a patent is refused. The applicant may waive reconsideration by the board of appeals and treat the decision, including the added grounds for refusal of a patent given by the board of appeals, as a final decision in the case.*

Should the decision of the board of appeals include a statement that the patent may be granted in amended form, applicant shall have the right to amend in conformity with such statement, which shall be binding on the primary examiner in the absence of new references or grounds of rejection" (italics supplied).

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# ***In the Supreme Court of the United States***

OCTOBER TERM, 1947

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No. 652

HAROLD E. EDGERTON, PETITIONER

v.

LAWRENCE C. KINGSLAND, COMMISSIONER OF PATENTS

---

*ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA*

---

**BRIEF FOR THE RESPONDENT IN OPPOSITION**

---

## **OPINIONS BELOW**

The District Court of the United States for the District of Columbia did not write an opinion. Its informal memorandum, findings of fact, and conclusions of law appear at R. 27-29. The opinion of the United States Court of Appeals for the District of Columbia (R. 579-586) is reported at 75 U. S. P. Q. 307.

## **JURISDICTION**

The judgment of the District Court was entered on April 16, 1946 (R. 30). The judgment of the Court of Appeals (R. 587) was entered December 4, 1947. A petition for rehearing was denied on January 6, 1948 (R. 588). The jurisdiction of this Court is invoked under Section 240(a)

of the Judicial Code, as amended by the Act of February 13, 1925.

#### QUESTION PRESENTED

In 1941 the Board of Appeals of the United States Patent Office affirmed a primary examiner's decision rejecting certain claims on the ground that they were not supported by the disclosure of the application. Other claims in the application for patent were still pending at that time and were not finally disposed of until more than three years later. After the final disposition of these remaining claims, the applicant brought a bill in equity under R. S. 4915, as amended (35 U. S. C. 63), to review the action of the Board of Appeals in rejecting various claims, including those which had been rejected in 1941, thus raising the following question:

Whether, as to the claims rejected in 1941, the six-month period within which a bill in equity to review that decision could be filed under R. S. 4915 ran from the date on which such claims were finally rejected, or from the date on which all claims in the patent application were finally disposed of.

#### STATUTES INVOLVED

The statutes involved, R. S. 4909, 4911 and 4915, as amended (35 U. S. C. 57, 59a and 63), are set forth in the Appendix, *infra*, pp. 12-13.

#### STATEMENT

Petitioner Harold E. Edgerton brought an equity proceeding in the District Court of the United States for the District of Columbia under R. S. 4915, as amended (35 U. S. C. 63), to obtain a judgment entitling him to the issuance of a patent containing claims 74, 76 to 81, and 222 of his application, No. 685,501 (R. 1-20).<sup>1</sup> Of these, only

<sup>1</sup> This suit was consolidated for trial (R. 64-65) with a similar suit relating to claims 12 and 14 (R. 49-59) and with a suit in the nature of a mandamus proceeding (R. 33-37) in which petitioner sought to compel respondent to allow certain amendments to the specification of his application, but these suits have no bearing on the issue presented here.



claims 74 and 76 to 81 are involved in the present petition (Pet. 13, 30).

Petitioner's application, filed in the Patent Office on August 16, 1933, was for a patent on a new and improved stroboscope, which is a means of producing intermittent or flashing light for viewing moving objects (R. 28, 207). The original application contained sixteen claims, but during the course of the examination of the application various amendments added a great many new claims and modified or cancelled prior claims (R. 221-224, 229-248, 500-501). While this application was pending two patents were issued to one Benjamin Miller for stroboscopic devices, and on June 11, 1937, the primary examiner declared an interference, identified as No. 74,402, between certain of petitioner's claims, including claims 74 and 76 to 81, and claims of the Miller patents (R. 249-255).

Interference No. 74,402 was later dissolved as to those counts which included petitioner's claims 74 and 76 to 81, these claims being

\* \* \* rejected on the ground that they are not readable on applicant's disclosure for the reason that he has not disclosed a "static inverter" as required by claims 74 and 76-81 \* \* \*. (R. 259).

A large number of petitioner's claims were allowed (R. 261), but claims 74 and 76 to 81, the static inverter<sup>2</sup> claims, were finally rejected by the primary examiner on December 23, 1940, this rejection being affirmed by the Board of Appeals of the Patent Office on August 1, 1941 (R. 262, 272-274). On September 16, 1941 the Board of Appeals adhered to its decision on a petition for rehearing (R. 275-276). Thereafter petitioner requested a reconsideration of the Board's decision, stating that his application was not in

<sup>2</sup> An explanation of the term "static inverter" is found at R. 182-183. It should be noted, however, that for the purposes of this brief it is not necessary to discuss the meaning of this term.

condition for review by the courts owing to the pendency of another interference (R. 277-278). This request was refused (R. 280) and, when it was renewed, it was refused again<sup>3</sup> on December 17, 1941 with the following comment:

\* \* \* Appellant's suggestion that the limit of appeal will not expire until the interference in which the present application is involved is terminated and after a long period of further *ex parte* prosecution has elapsed is not convincing to us (R. 281).

*Ex parte* action on the application was resumed when the second interference was terminated, and on March 24, 1943 the claims here involved were refused further consideration on the ground that the previous final rejection of them was *res judicata* as the time for further appeal had expired (R. 286, 500). This ruling was affirmed by the Board of Appeals on January 1, 1945 (R. 511-513, 516), and after making various efforts to obtain a reversal of this ruling in the Patent Office,<sup>4</sup> petitioner instituted the present proceeding in the United States District Court for the District of Columbia on June 1, 1945.

After a hearing the District Court filed an informal memorandum, findings of fact, and conclusions of law rejecting the static inverter claims not only on the ground that they were barred by the principle of *res judicata* because of petitioner's failure to file either an appeal to the United States Court of Customs and Patent Appeals or a complaint under R. S. 4915 within the time allowed, but also on

<sup>3</sup> Petitioner thereafter requested the primary examiner to take further action on claims 74 and 76 to 81, which request was refused, and a petition for supervisory action was likewise denied by the Assistant Commissioner of Patents (R. 284, 285).

<sup>4</sup> On request for reconsideration the Board of Appeals adhered to its decision with regard to the claims here involved, though it reversed its decision as to other claims (R. 517-520). A petition to respondent Commissioner of Patents to overrule the rejection of these claims was denied (R. 521-524, 547-548).

the ground that they were not supported by the disclosure of petitioner's application, the ground on which they were originally rejected by the primary examiner and the Board of Appeals (R. 27-29, 259, 262, 272-274). On April 16, 1946 the District Court entered judgment dismissing petitioner's complaint (R. 30). On appeal the Court of Appeals for the District of Columbia considered it necessary to discuss only the *res judicata* question, and affirmed the District Court on that ground on the authority of this Court's decision in *Hoover Co. v. Coe*, 325 U. S. 79, which was deemed to be controlling (R. 582-583, 586).

#### ARGUMENT

The sole question presented by the petition herein is whether, under R. S. 4915, as amended (35 U. S. C. 63), a patent applicant must bring his bill in equity within six months after each separate final decision in the Patent Office involving one or more claims in his application, or whether the applicant may wait until after a final decision upon all the claims in the application and then bring his bill in equity within six months of such final decision (Pet. 2). We submit that in ruling that the equity proceeding must be brought within six months after the final refusal by the Patent Office of any claim the court below correctly interpreted R. S. 4915 and properly applied the decision of this Court in *Hoover Co. v. Coe*, 325 U. S. 79, and that, in any event, the petitioner has failed to show that the rejection of his static inverter claims by the primary examiner, the Board of Appeals, and the District Court was clearly erroneous.

1. Petitioner relies entirely on the general rule that the piecemeal disposition on appeal of a single controversy is not permissible (Pet. 15-24). In this context petitioner, conceding that an applicant's right to a judicial determination of the question as to whether he is entitled to a patent

is based solely on R. S. 4915,<sup>5</sup> urges an interpretation of that statute which would prohibit a patent applicant from resorting to a bill in equity after an adverse final decision in the Patent Office on any individual claim, and would make this relief available to him only after there has been a final decision as to all his claims (Pet. 24-28). However, as the court below pointed out (R. 582), that statute has already been construed by this Court adversely to petitioner's contention in *Hoover Co. v. Coe*, 325 U. S. 79.

In the *Hoover Co.* case an applicant for a reissue of a patent included in his application a number of claims copied from later patents in order to provoke interferences therewith. The decision of the primary examiner rejecting four of the claims as not reading on applicant's disclosure was affirmed by the Board of Appeals of the Patent Office. The applicant then brought suit against the Commissioner of Patents under R. S. 4915, and the complaint was dismissed by the District Court on the ground that the claims did not read on the disclosure. The Court of Appeals for the District of Columbia dismissed the appeal on its own motion, holding that since the District Court could not enter a decree authorizing the issuance of a patent because of the impending interference proceeding, a court of equity ought not to afford piecemeal relief pending completion of the administrative process and therefore ought not to entertain a suit under R. S. 4915 unless its adjudication would conclude all possible questions as to the right to a patent. This Court reversed that ruling, holding that the decision of the Board of Appeals finally denied a patent on the claims presented and so was like a dismissal of a suit in court, and that under R. S. 4915 the applicant could sue to correct error in that dismissal.

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<sup>5</sup> On an appeal to the Court of Customs and Patent Appeals under R. S. 4911 that court acts in an administrative capacity on the Patent Office record, and its decision cannot be reviewed in this or any other court. *Postum Cereal Co. v. California Fig Nut Co.*, 272 U. S. 693, 699.

Petitioner seeks to distinguish *Hoover Co. v. Coe* on the ground that in that case there had been a final decision by the Patent Office upon all the claims in controversy, and hence the action of the Court of Appeals for the District of Columbia had been a misapplication of the rule prohibiting piecemeal review (Pet. 28-29). However, there is nothing in this Court's opinion to indicate that in that case all claims had been disposed of prior to the bringing of the suit,\* or that the final disposition of all claims was considered by this Court as a condition precedent to the bringing of the suit. Instead, this Court pointed out that the right of appeal to the United States Court of Customs and Patent Appeals under R. S. 4911 (35 U. S. C. 59a) and the right to bring a bill in equity under R. S. 4915 (35 U. S. C. 63) in a federal district court are alternative rights of review accorded a patent applicant, and then said (325 U. S. at 83-84):

The question is whether the differences in the character of the proceedings and the statutory effect of decision or adjudication require a holding that as to all decisions on the merits adverse to the applicant, other than the final action as to the issue of a patent, the applicant must obtain review by appeal to the Court of Customs and Patent Appeals, and can proceed by bill under R. S. 4915 only when every step requisite to issue has been taken. If so, the language of R. S. 4915 is ill chosen. \* \* \*

Petitioner has apparently failed to grasp the full significance of this Court's holding that a final decision in the Patent Office may be reviewed by bill in equity under R. S. 4915 whenever the same decision could be reviewed on

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\* Even an examination of the record in *Hoover Co. v. Coe*, No. 486, October Term, 1944, sheds little light on this point. The ruling of the primary examiner (pp. 113-115) rejecting the claims as to which suit was brought shows the disposition made of 31 of a total of 41 claims, but there is nothing to indicate whether the remaining 10 claims (claims 24 to 33, inclusive) had been cancelled or previously rejected, or were still pending.

appeal to the Court of Customs and Patent Appeals under R. S. 4911. R. S. 4911 gives “\* \* \* any applicant \* \* \* dissatisfied with the decision of the board of appeals \* \* \*” the right to appeal to the Court of Customs and Patent Appeals. With regard to the matters which may be taken to the Board of Appeals, R. S. 4909 provides:

Every applicant for a patent or for the reissue of a patent, *any of the claims of which have been twice rejected*, may appeal from the decision of the primary examiner to the Board of Appeals, having once paid the fee for such appeal. [Italics supplied.]

Thus the statutes clearly provide that the rejection of any claim in a patent application may be appealed to the Board of Appeals, and any decision of the Board of Appeals may be appealed to the Court of Customs and Patent Appeals, and as a matter of practice that court has entertained appeals in cases in which all claims had not been finally disposed of in the Patent Office. *In re Gillam*, 37 F. 2d 959; *In re Rundell*, 55 F. 2d 450; *In re Robertshaw*, 75 F. 2d 203. Since the remedies under R. S. 4911 and 4915 are alternative remedies, it follows that the rejection of any claim in a patent application gives the applicant a right to a judicial determination on a bill in equity as to whether he is entitled to a patent which includes such claim, without the necessity of waiting until there had been a final disposition of all claims.

Petitioner asserts that the Patent Office has heretofore construed R. S. 4915 in a way inconsistent with its present position, citing *Ex parte King*, 366 Official Gazette 3, an opinion rendered by Acting Commissioner Kinnan in 1927 (Pet. 26-27, 31-34). That opinion, however, purports to be no more than a construction of the Patent Office's Rule 139, and is simply a determination by the Commissioner of Patents as to the time when certain decisions of the Board



of Appeals shall be considered final. But even if it were true that in 1927 the Patent Office had construed R. S. 4915 in accordance with petitioner's present contention, that construction had obviously been changed in 1941, when the Board of Appeals rendered its final decision as to petitioner's static inverter claims. At that time the Board rejected as "not convincing" petitioner's suggestion that his time for appeal from its decision would not expire until the termination of an interference in which his application was then involved (R. 281). Petitioner was thus put on notice that, at least in the view of the members of the Board of Appeal, the period of six months within which he must seek a review of that decision by a bill in equity under R. S. 4915 was reckoned from the date of the decision.

Petitioner's contention (Pet. 26) that the term "his claim" in R. S. 4915 means "all claims," so that an equity action would lie only after a final rejection of all claims in the application, ignores the fact that under R. S. 4915 a bill in equity will lie to determine whether the "• • • applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim *or for any part thereof*, as the facts in the case may appear" [Italics supplied]. This indicates that the controversy presented may be the validity of only a part of the subject matter of the entire application. The words "as specified in his claim, or for any part thereof" originated in Section 16 of the Patent Act of 1836, c. 357, 5 Stat. 117, 123-124. Under the practice then prevailing, there was only one claiming paragraph, sometimes called the "claim" or the "claiming part," and when more than one claim was made in an application, they were included in the claim paragraph separated only by a phrase such as "I also claim." Thereafter, the current practice evolved of inserting separate claims in separately numbered paragraphs. See Lutz, *Evolution of the Claims of United States Patents*, 20 Journ. Pat. Off. Soc. 457, 469.

Hence the words "as specified in his claim or for any part thereof" refer to all the claims in the application or to any one of them. The cases cited by petitioner (Pet. 26) as construing the words "his claim" in R. S. 4915 to mean "all the claims" are suits for patent infringement which did not involve R. S. 4915 and in which that statute is not even discussed. We submit, therefore, that the court below properly applied the decision of this Court in *Hoover Co. v. Coe*, 325 U. S. 79, and was correct in holding that under R. S. 4915 a final decision of the Board of Appeals rejecting any claim in a patent application was *res judicata* as to that claim, where no appeal was taken to the Court of Customs and Patent Appeals and where the applicant did not bring a bill of equity in a district court within six months, even though there were other claims still pending in the Patent Office.

2. It should be noted that, in so far as petitioner is concerned, the question of the correct interpretation of R. S. 4915 is academic, as petitioner has made no showing that he is entitled to relief on the merits. Petitioner's static inverter claims were rejected by the primary examiner and the Board of Appeals on the ground that they were not readable on the disclosure of his application, a purely factual issue. The reasons why the claims did not read on the disclosure are set forth in the Board of Appeals' decision of September 16, 1941, on petition for rehearing (R. 275-276). Although petitioner charges that the Patent Office's lack of familiarity with the art was responsible for these rulings, and complains that he was not allowed to present certain testimony supporting his claims until the trial of this cause in the District Court (Pet. 8), he neglects to mention that after a full hearing the District Court also found that the disclosure in the application did not support any of the claims here involved and dismissed petitioner's



suit on that ground as well as on the ground that the Board of Appeals decision on these claims had become *res judicata* (R. 29). Although this ground of decision was not considered by the court below on the appeal, in the review of proceedings under R. S. 4915 that court has consistently applied the well-established rule that findings of fact of the trial court will not be disturbed unless clearly erroneous or without support in the evidence. *Abbott v. Coe*, 109 F. 2d 449, 451; *Forward Process Co. v. Coe*, 116 F. 2d 946, 947; *Minnesota Mining & Mfg. Co. v. Coe*, 118 F. 2d 593, 594, certiorari denied, 314 U. S. 624; *General Motors Corporation v. Coe*, 120 F. 2d 736, 737, certiorari denied, 314 U. S. 688; *Sharp v. Coe*, 125 F. 2d 185. This rule has peculiar force where, as here, the contested finding has been concurred in by both the Patent Office and the District Court. *Abbott v. Coe*, *supra* at p. 452; cf. *United States v. Commercial Credit Co., Inc.*, 286 U. S. 63, 67.

#### CONCLUSION

The decision below is correct and there is no conflict of decisions. It is, therefore, respectfully submitted that the petition for writ of certiorari should be denied.

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## APPENDIX

Revised Statutes 4909, 4911 and 4915, as amended (35 U.S.C. 57, 59a and 63), provide as follows:

SEC. 4909. Every applicant for a patent or for the reissue of a patent, any of the claims of which have been twice rejected, may appeal from the decision of the primary examiner to the Board of Appeals, having once paid the fee for such appeal.

SEC. 4911. If any applicant is dissatisfied with the decision of the board of appeals, he may appeal to the United States Court of Customs and Patent Appeals, in which case he waives his right to proceed under section 4915 of the Revised Statutes. [U.S.C., title 35, sec. 63.] If any party to an interference is dissatisfied with the decision of the board of interference examiners, he may appeal to the United States Court of Customs and Patent Appeals, provided that such appeal shall be dismissed if any adverse party to such interference shall, within twenty days after the appellant shall have filed notice of appeal according to section 4912 of the Revised Statutes [U.S.C., title 35, sec. 60], file notice with the Commissioner of Patents that he elects to have all further proceedings conducted as provided in section 4915 of the Revised Statutes. Thereupon the appellant shall have thirty days thereafter within which to file a bill in equity under said section 4915, in default of which the decisions appealed from shall govern the further proceedings in the case.

SEC. 4915. Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to

adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit.